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Attorneys for Plaintiff Leupold & Stevens, Inc.

UNITED STATES DISTRICT COURT  
DISTRICT OF OREGON  
PORTLAND DIVISION

LEUPOLD & STEVENS, INC.,

Plaintiff / Counterclaim-Defendant,

v.

LIGHTFORCE USA, INC. d/b/a  
NIGHTFORCE OPTICS and  
NIGHTFORCE USA.

Defendant / Counterclaimant.

No. 3:16-cv-1570-HZ

**NOTICE OF FILING PLAINTIFF  
LEUPOLD & STEVENS MARKMAN  
HEARING PRESENTATION  
MATERIALS (JANUARY 8, 2018)**

Attached as **Exhibit 1** is a copy of the presentation slides Plaintiff Leupold & Stevens, Inc. used at the claim construction hearing on January 8, 2018.

Respectfully submitted this 11th day of January, 2018

STOEL RIVES LLP

s/ Nathan C Brunette

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Attorneys for Plaintiff  
Leupold & Stevens, Inc.

# **Exhibit 1**

## 1. U.S. Pat. No. 8,006,429: Telescopic Sight

Leupold's Proposed Construction	Nightforce's Proposed Construction
a magnifying firearm aiming device	an instrument with an arrangement of lenses and/or mirrors that gathers visible light allowing direct observation or photographic recording of distant objects.

## 1

## LOCKING TURRET KNOB

## RELATED APPLICATIONS

This application is a national phase entry under 35 U.S.C. §371 of International Application No. PCT/US2005/043336, filed Nov. 30, 2005 and claims the benefit under 35 U.S.C. §119(e) of U.S. Provisional Patent Application Ser. No. 60/632,331, filed Nov. 30, 2004 and U.S. Provisional Patent Application Ser. No. 60/638,561, filed Dec. 22, 2004, which are incorporated by reference herein.

## BACKGROUND

The present disclosure relates to an optical enhancing device, such as a telescopic observation sighting device or individual shoulder (or hand-fired) firearms sighting device (telescopic sight herein). Embodiments described herein may also be used with any optical enhancing device containing adjusters, such as a microscope, telescope, etc. For purposes of illustration, it will be assumed herein that the optical enhancing device is a telescopic sight.

A telescopic sight, typically used to aim a firearm, is usually mounted on the firearm. An adjustment knob on a telescopic sight is typically used for changing a setting of an adjuster that may change the adjustment of, for example, elevation, crossrange (also "windage" herein), or parallax of the telescopic sight. Parameters such as elevation, crossrange, and parallax, may be painstakingly set in order that the firearm hit a specific target. Once set for a particular target, the setting preferably remains unchanged until after a shot is fired.



## 4. U.S. Pat. No. 9,665,120: Sighting Device

Leupold's Proposed Construction	Nightforce's Proposed Construction
an <b>aiming</b> device	a device for <b>observation</b> with an optical enhancing device such as a telescope or riflescope

## 1

## LOCKING TURRET KNOB

## RELATED APPLICATIONS

This application is a national phase entry under 35 U.S.C. 5  
 §371 of International Application No. PCT/US2005/043336,  
 filed Nov. 30, 2005 and claims the benefit under 35 U.S.C.  
 §119(e) of U.S. Provisional Patent Application Ser. No.  
 60/632,331, filed Nov. 30, 2004 and U.S. Provisional Patent  
 Application Ser. No. 60/638,561, filed Dec. 22, 2004, which 10  
 are incorporated by reference herein.

## BACKGROUND

The present disclosure relates to an optical enhancing 15  
 device, such as **a telescopic observation sighting device or  
 individual shoulder (or hand-fired) firearms sighting device  
 (telescopic sight herein)**. Embodiments described herein may  
 also be used with any optical enhancing device containing  
 adjusters, such as a microscope, telescope, etc. For purposes 20  
 of illustration, it will be assumed herein that the optical  
 enhancing device is a telescopic sight.

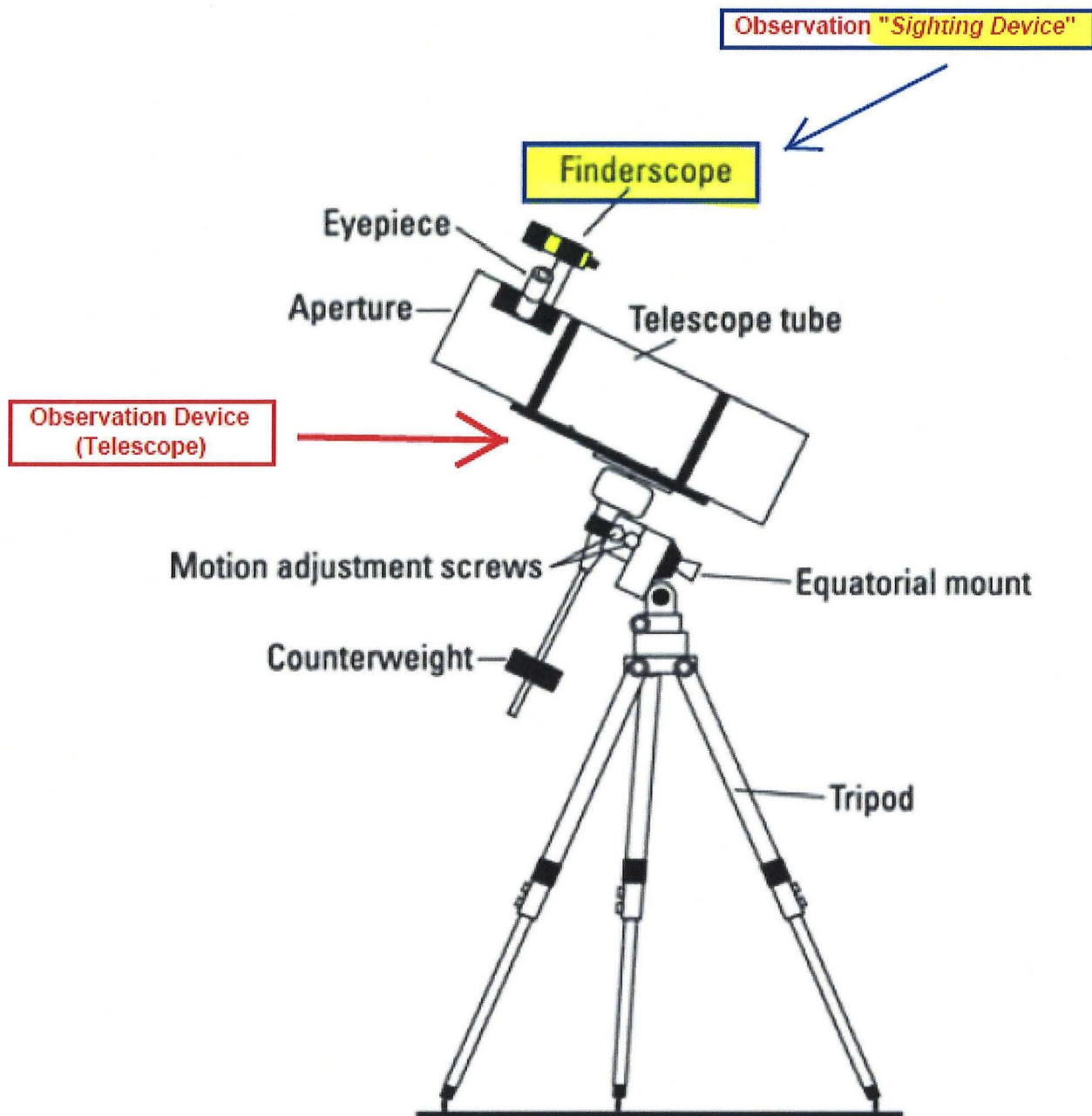
**A telescopic sight, typically used to aim a firearm,** is usu-  
 ally mounted on the firearm. An adjustment knob on a tele-  
 scopic sight is typically used for changing a setting of an 25  
 adjuster that may change the adjustment of, for example,  
 elevation, crossrange (also "windage" herein), or parallax of  
 the telescopic sight. Parameters such as elevation, crossrange,  
 and parallax, may be painstakingly set in order that the fire-  
 arm hit a specific target. Once set for a particular target, the 30  
 setting preferably remains unchanged until after a shot is  
 fired.



## 4. U.S. Pat. No. 9,665,120: Sighting Device

Leupold's Proposed Construction	Nightforce's Proposed Construction
an <b>aiming</b> device	a device for <b>observation</b> with an optical enhancing device such as a telescope or riflescope

Example from Telescope  
(re understanding of OSA)





## 1. U.S. Pat. No. 8,516,736: Actuator / Lock Actuator / Drives

	Leupold's Proposed Construction	Nightforce's Proposed Construction
Actuator	Plain meaning. Needs no construction.  Alternatively: a device that puts another structure into motion or action	a motor-driven device that is connected to a computer and is responsive to commands from the computer
Lock Actuator	a structure that operates the locking mechanism	a motor-driven device that is connected to a computer and adjusts the locking mechanism in response to computer commands
Drives	moves by force	motor-supplied movement of a component to propel another component

,736 B2

4

FIG. 10 shows a flow diagram for making a locking turret knob according to one embodiment.

## DETAILED DESCRIPTION

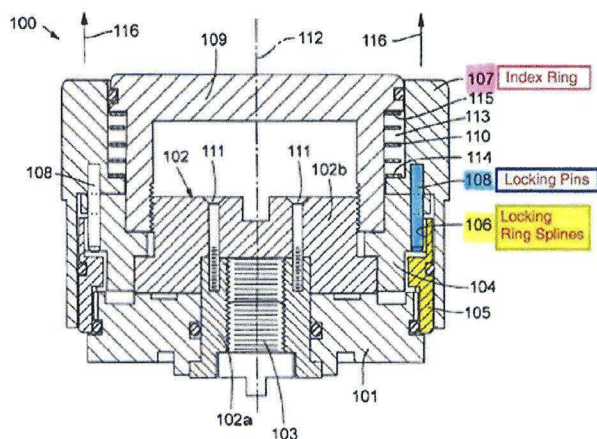
According to one embodiment, an adjustment knob is provided for an optical setting, such as elevation, windage, parallax, or illuminated reticle power control of an optical-based instrument, such as a telescopic sighting system, a telescope or a microscope, that is mechanically lockable and weather proof, thereby eliminating inadvertent adjustment of an optical setting by accidental physical contact. Accordingly, the user may mechanically unlock the adjustment knob to make a desired adjustment of an optical or power setting. Thus, optical or power settings made by a user are reliably maintained regardless of the environmental conditions or whether the adjustment knob is accidentally touched.

1. U.S. Pat. No. 8,516,736: The Second Portion **Selectively Movable Between Locked and Unlocked Positions**

Leupold's Proposed Construction	Nightforce's Proposed Construction
<p>Plain meaning. Needs no construction.</p> <p>Alternatively: the second portion is moveable <b>by a user</b> between a first position where it is unable to be rotated about the axis of rotation <b>relative to the firearm sighting device</b>, and a second position where it is able to be rotated about the axis of rotation relative to the firearm sighting device</p>	<p>The second portion is moveable between a first position where it is unable to be rotated about the axis of rotation, and a second position where it is able to be rotated about the axis of rotation, <b>where the first position is chosen from multiple positions where the second portion is unable to be rotated about the axis of rotation.</b></p>

**Fig. 1**  
(side view of turret knob – locked)

U.S. Patent Aug. 27, 2013 Sheet 1 of 10 US 8,516,736 B2



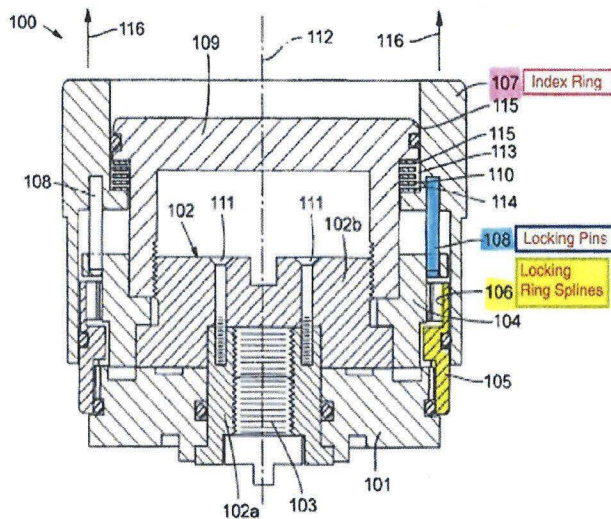
**FIG. 1**

**LOCKED**

See, e.g., '736 patent, col. 4:66 - col. 5:9.

**Fig. 2**  
(side view of turret knob – unlocked)

U.S. Patent Aug. 27, 2013 Sheet 2 of 10 US 8,516,736 B2



**FIG. 2**

**UNLOCKED**

See, e.g., '736 patent, col. 4:66 - col. 5:9.



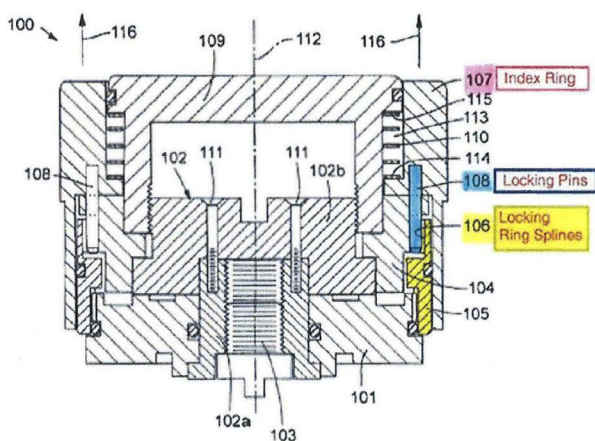
1. U.S. Pat. No. 9,665,120: Engage **One Another** in a Locked Position

Leupold's Proposed Construction	Nightforce's Proposed Construction
secure in position to prevent rotation <b>relative to one another</b> <sup>1</sup>	unable to be <b>rotated about the axis of rotation</b> of the knob

<sup>1</sup> In Leupold's opening brief, this proposed construction included a typographical error by inserting the word "and" instead of "to." Leupold Brief at 20. The Joint Claim Construction Chart contains the accurate version of Leupold's proposed construction for this term (Dkt. 45 at 93) and is reproduced here.

**Fig. 1**  
(side view of turret knob – locked)

U.S. Patent Aug. 27, 2013 Sheet 1 of 10 US 8,516,736 B2



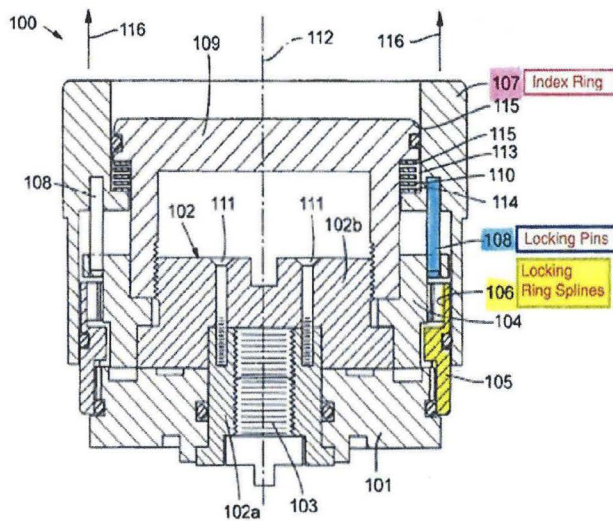
**FIG. 1**

**LOCKED**

See, e.g., '736 patent, col. 4:66 - col. 5:9.

**Fig. 2**  
(side view of turret knob – unlocked)

U.S. Patent Aug. 27, 2013 Sheet 2 of 10 US 8,516,736 B2



**FIG. 2**

**UNLOCKED**

See, e.g., '736 patent, col. 4:66 - col. 5:9.

3. U.S. Pat. No. 9,170,068: [A] Locking Adjustment Device for Adjusting a Setting of a Riflescope or Other Aiming Device

Leupold's Proposed Construction	Nightforce's Proposed Construction
a securable adjuster of a weapon targeting device	<p><u>"for adjusting a setting of a riflescope or other aiming device"</u> is not an element of the claims for two reasons: 1) it is preamble; and 2) it is intended use language.</p> <p>To the extent it is considered an element of the claims <u>"or other aiming device"</u> includes <u>any optics device</u> that benefit from adjustment of one or more of parallax, focus, illumination brightness, or other suitable features, including riflescopes, telescopes, binoculars, spotting scopes, and other aimed optical devices.</p> <p><u>Cameras and video cameras are not excluded</u></p>

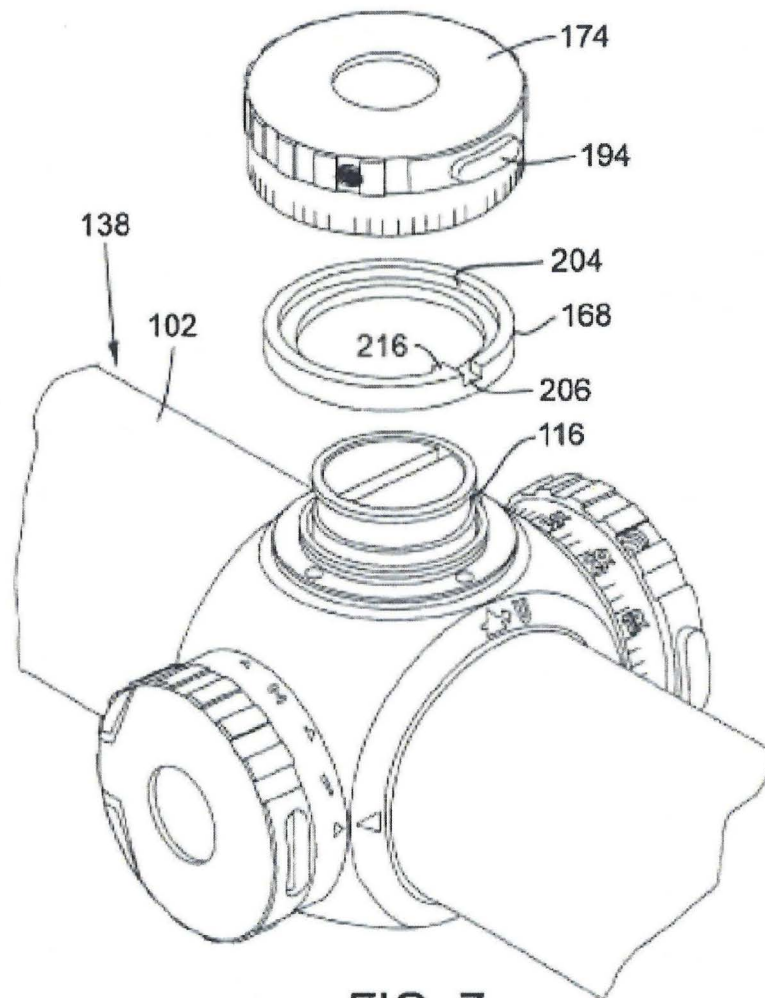


FIG. 7



## 7. U.S. Pat. No. 9,170,068: Around

Leupold's Proposed Construction	Nightforce's Proposed Construction
Plain meaning. Needs no construction. Alternatively: to the side of	on all sides of; encircle

Case 3:16-cv-01570-HZ Document 53-26 Filed 11/08/17 Page 1 of 5

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Quint Crispin

Confirmation No. 1045

Application No. 13/343,656

Filed: January 4, 2012

For: LOCKING ADJUSTMENT DEVICE

Group Art Unit: 3641

Examiner: Benjamin S. Gumbert

Attorney Docket No. 48139/5930

Date: June 24, 2015

**AMENDMENT AND RESPONSE TO FINAL OFFICE ACTION**

TO THE COMMISSIONER FOR PATENTS:

In response to the March 11, 2015 Office action, please amend the above-identified patent application as follows.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this paper.

Remarks begin on page 5 of this paper.

792K7098.1 0048139-05930

L&amp;S002202

Exhibit 26  
Page 1 of 5

Case 3:16-cv-01570-HZ Document 53-26 Filed 11/08/17 Page 2 of 5

**Listing of Claims:**

- (Currently Amended) A locking adjustment device for adjusting a setting of a rifle scope or other aiming device, comprising:  
a guideway including a curved slide surface extending around a rotational axis, and a notch formed at a first end of in the curved slide surface;  
a knob mountable over the guideway for rotation about the rotational axis when the adjustment device is installed on the aiming device;  
a guide tab carried by the knob for rotation therewith and slidably received in the guideway when the adjustment device is installed on the aiming device, the guide tab being movable relative to the knob and biased against the curved slide surface so as to urge at least a portion of the guide tab toward the notch when the knob is rotated to a locked position at which the guide tab is aligned with the notch, thereby preventing inadvertent rotation of the knob relative to the aiming device from the locked position; and  
a button carried by the knob for rotation therewith, the button operably associated with the guide tab and movable therewith relative to the knob when the button is manually depressed to urge the guide tab out of the notch and thereby allow the knob to be manually rotated about the rotational axis away from the locked position.
- (Currently Amended) The locking adjustment device of claim 1, wherein the guideway includes a second curved slide surface extending around the axis and linked to the curved slide surface via a transition section, wherein the guide tab is movable along the second curved slide surface and the transition section when the knob is rotated.
- (Currently Amended) The locking adjustment device of claim 2, wherein the guideway includes a second end on the second curved slide surface, and wherein the second end defines includes a stop that blocks the guide tab to limit rotation of the knob beyond the second end stop.
- (Currently Amended) The locking adjustment device of claim 3, wherein the guideway is spiraled and the curved slide surface is at a first radial position from the rotational axis and the second curved slide surface is at a second radial position from the rotational axis.

792K7098.1 0048139-05930

2

L&amp;S002203

Exhibit 26  
Page 2 of 5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

**Quint Crispin**

Confirmation No. 1045

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**Amendments to the Claims** are reflected in the listing of claims that begins on page 2 of this paper.

**Remarks** begin on page 5 of this paper.

79287098.1 0048139-05930

L&S002202

Exhibit 26

**Listing of Claims:**

1. (Currently Amended) A locking adjustment device for adjusting a setting of a riflescope or other aiming device, comprising:

a guideway including a **curved** slide surface extending around a rotational axis, and a notch formed ~~at a first end of~~ in the **curved** slide surface;

a knob mountable over the guideway for rotation about the rotational axis when the adjustment device is installed on the aiming device;

a guide tab carried by the knob for rotation therewith and slidably received in the guideway when the adjustment device is installed on the aiming device, the guide tab being movable relative to the knob and biased against the **curved** slide surface so as to urge at least a portion of the guide tab toward the notch when the knob is rotated to a locked position at which the guide tab is aligned with the notch, thereby preventing inadvertent rotation of the knob relative to the aiming device from the locked position; and

a button carried by the knob for rotation therewith, the button operably associated with the guide tab and movable therewith relative to the knob when the button is manually depressed to urge the guide tab out of the notch and thereby allow the knob to be manually rotated about the rotational axis away from the locked position.

2. (Currently Amended) The locking adjustment device of claim 1, wherein the guideway includes a second **curved** slide surface extending around the axis and linked to the **curved** slide surface via a transition section, wherein the guide tab is movable along the second **curved** slide surface and the transition section when the knob is rotated.

3. (Currently Amended) The locking adjustment device of claim 2, wherein the guideway ~~includes a second end on the second **curved** slide surface, and wherein the second end defines~~ includes a stop that blocks the guide tab to limit rotation of the knob beyond the ~~second end stop.~~

4. (Currently Amended) The locking adjustment device of claim 3, wherein the guideway is spiraled and the **curved** slide surface is at a first radial position from the rotational axis and the second **curved** slide surface is at a second radial position from the rotational axis.



5. (Currently Amended) The locking adjustment device of claim 1, further comprising an indicator unit carried by the knob and movable relative to the knob, the indicator unit visible on a surface of the knob, wherein the indicator unit is at a first position when the guide tab is aligned with the notch and at a second position when the guide tab is positioned along the curved slide surface away from the ~~first end~~ notch.

6. (Previously Presented) The locking adjustment device of claim 5, wherein the indicator unit is coupled to the guide tab, and the locking adjustment device further comprises a biasing element operatively associated with the guide tab and the indicator unit to urge movement of the indicator unit from the second position to the first position.

7. (Original) The locking adjustment device of claim 5, wherein the indicator unit is slidably received in a slot arranged on the surface of the knob.

8. (Currently Amended) The locking adjustment device of claim 3, further comprising:  
an indicator unit coupled to the guide tab and visible on a surface of the knob; and  
a biasing element operatively associated with the guide tab and the indicator unit,  
wherein the indicator unit is at a first position when the guide tab is aligned with the notch, a second position when the guide tab is positioned along the curved slide surface away from the notch, and a third position when the guide tab is positioned along the second curved slide surface, and wherein the biasing element urges movement of the indicator unit from the third position to the second position and from the second position to the first position.

9. (Previously Presented) The locking adjustment device of claim 1, wherein the aiming device includes a housing and the locking adjustment device further comprises:

a spindle mounted to the housing for rotation about the axis; and  
a threaded plunger extending within the housing of the aiming device and threadably coupled to the spindle, wherein rotation of the spindle about the axis causes movement of the threaded plunger along the axis.

10. (Original) The locking adjustment device of claim 9, wherein the guideway is formed along a substantially circular guide ring.

11. (Previously Presented) The locking adjustment device of claim 10, further comprising a retaining ring surrounding the spindle for securing the spindle to the housing, wherein the guide ring is press fit to the retaining ring.

12. (Previously Presented) The locking adjustment device of claim 1, wherein the notch extends in a radial direction relative to the rotational axis, and wherein the guide tab is biased in the radial direction.

13. (Previously Presented) The locking adjustment device of claim 12, wherein the guide tab extends inwardly within the knob toward the aiming device.

14-20. (Cancelled)

21. (Previously Presented) The locking adjustment device of claim 1, wherein the guideway comprises a channel.

22. (Previously Presented) The locking adjustment device of claim 1, wherein a radial distance from the guide tab to the rotational axis changes when the button is depressed.

23. (Currently Amended) The locking adjustment device of claim 1, wherein the guide tab automatically transitions from the **curved** slide surface into the notch when the knob is rotated to the locked position.

24. (New) The locking adjustment device of claim 1, wherein the knob further includes a scale comprising indicia spaced apart on a circumference of the knob to facilitate fine adjustments.

25. (New) The locking adjustment device of claim 1, wherein the locked position corresponds to a baseline position of the adjustable setting.

### Remarks

Claims 1-23 are in the application, of which claims 1 and 14 are in independent form. Claims 1-5, 8, and 23 have been amended and dependent claims 24 and 25 have been added without adding new matter. Claims 14-20 have been cancelled.

### *Allowable Subject Matter*

The Office action mailed March 11, 2015 indicates claims 1-13 and 21-23 are allowed. Applicant thanks the examiner for favorable consideration of these claims.

### *Claim Rejections*

The Office action rejects claims 14-20 under 35 U.S.C. § 102(b) as being unpatentable over WO 2010/008810 of Windauer. To expedite prosecution, claims 14-20 have been cancelled from the application. Accordingly, the rejection is moot and it is requested that the rejection be withdrawn.

### New Claims 24 and 25

Claims 24-25, which depend from claim 1, have been added. Accordingly, dependent claims 24-25 should be allowable at least because they depend from an allowable base claim.

### *Conclusion*

Thus it is respectfully submitted that claims 1-13 and 21-25 are allowable and a Notice of Allowance is earnestly solicited. The Examiner is invited to contact the undersigned attorney if it determined that such communication would promote progress of this application.

This Response is being timely filed within four months of the date of the Office action. The Commissioner is hereby authorized to charge any *additional* fees which may be required in connection with filing of this paper, or credit overpayment, to Deposit Acct. No. 19-4455.

Respectfully submitted,

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Alfredo Villanueva  
Registration No. 66,301

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***Leupold and Stevens, Inc. v.  
Lightforce USA, Inc.***

**Case No. 3:16-cv-01570-HZ**

**Jan. 8, 2018 *Markman* Hearing**



# **U.S. Patent No. 6,351,907**

## ***Spiral Cam Mechanism for Rifle Sight Adjustment***

# ILLUSTRATIVE EXAMPLE OF OPERATION:


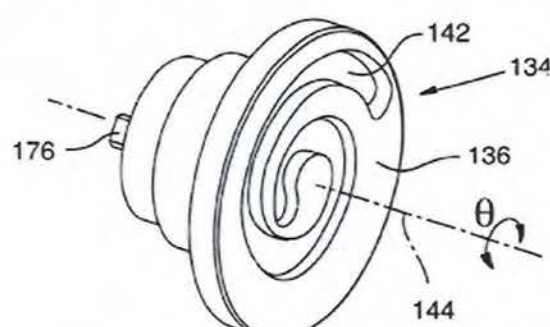
## **LEUPOLD & STEVENS, INC.**

*U.S. Patent No. 6,351,907: Sprial Cam Mechanism for Rifle Sight Adjustment  
(Claim Terms: "Along the Longitudinal Axis", "Drive Face", "Cam Track", & "Cam Follower")*

# “Drive Face”



# DESCRIPTION IN THE SPECIFICATION

 US 6,351,907 B1	
<b>United States Patent</b> Otteman	
(10) Patent No.: <b>US 6,351,907 B1</b> (45) Date of Patent: <b>Mar. 5, 2002</b>	
(51) <b>SPIRAL CAM MECHANISM FOR RIFLE SIGHT ADJUSTMENT</b>	
(75) Inventor: <b>Rodney H. Otteman, Aloha, OR (US)</b>	
(73) Assignee: <b>Leupold &amp; Stevens, Inc., Beaverton, OR (US)</b>	
(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.	
(12) Appl. No.: <b>09/484,963</b> (22) Filed: <b>Jan. 31, 2000</b> (51) Int. Cl.: <b>F41G 1/00</b> (52) U.S. Cl.: <b>42/120</b> (58) Field of Search: <b>35/245-250, 359-360, 360/693, 360/247, 360/187, 42/122</b>	
(59) References Cited	
U.S. PATENT DOCUMENTS 2,580,042 A * 1/1952 Davies ..... 33/246 2,811,894 A * 11/1957 Baker ..... 33/246 3,065,750 A * 7/1963 Maki ..... 34/107 3,615,544 A 10/1971 Pillat et al. .... 38/45 3,765,751 A 10/1973 Naguchi ..... 350/242 3,980,720 A 1/1976 Giesing ..... 350/187 4,000,501 A 12/1976 Saitoguchi et al. .... 354/197 4,080,043 A * 1/1978 Aleksandrov et al. .... 350/76 4,247,391 A * 1/1980 Unoff, Jr. .... 33/246 4,645,547 A 2/1987 Gilman ..... 350/662 4,990,811 A * 5/1991 Bawa ..... 350/580 5,020,892 A * 6/1991 Gilman et al. .... 350/537 5,115,261 A * 6/1992 Montoya ..... 350/225	
FOREIGN PATENT DOCUMENTS DE 247 20 737 6/1998 * cited by examiner	
Primary Examiner—Michael J. Corbett Assistant Examiner—Deanne J. Buckley (74) Attorney, Agent, or Firm—Stoel Rives LLP	
(57) <b>ABSTRACT</b> A focus adjustment mechanism for a telescopic rifle sight includes a rotatable cam hub including a drive face and a spiral cam track formed in the drive face around an axis of rotation. An actuator slide of the adjustment mechanism is slidably mounted to a housing of the telescopic rifle sight for movement along a longitudinal axis of the housing. The actuator slide includes a cam follower that is operably engaged in the spiral cam track so that the actuator slide moves generally along the longitudinal axis in response to rotation of the cam hub to changing a setting of the adjustment mechanism. The actuator slide is operatively connected to a movable optical element positioned within the housing of the telescopic rifle sight to drive the optical element in response to rotation of the cam hub. The rate of linear movement of the optical element relative to the rate of rotation of the cam hub is controlled by the shape and arcuate angle of the spiral cam track. A spring biases the actuator slide relative to the housing to prevent rifle recoil from inducing changes to the setting of the adjustment mechanism.	
<b>20 Claims, 5 Drawing Sheets</b>	
	


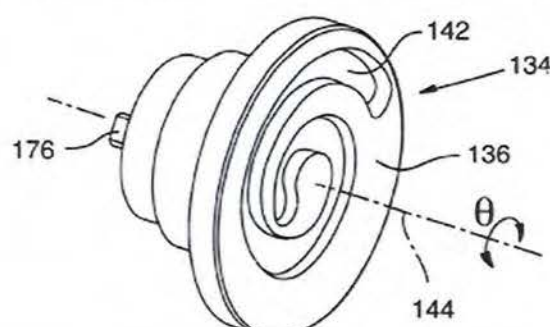
Col. 3, ll. 28-36; Col. 5 ll. 50-67; Fig. 6B.

5


**STOEL RIVES LLP**

# DESCRIPTION IN THE SPECIFICATION

The focus control knob of the present invention includes a cam hub mounted to the housing for rotation about an axis of rotation. The cam hub includes a drive face positioned facing the interior of the housing and a spiral cam track formed in the drive face around the axis of rotation and spiraling outwardly from the axis of rotation. An actuator

 US006351907B1	
<b>United States Patent</b> <b>Ottoman</b>	
(10) Patent No.: <b>US 6,351,907 B1</b> (45) Date of Patent: <b>Mar. 5, 2002</b>	
(51) <b>SPIRAL CAM MECHANISM FOR RIFLE SIGHT ADJUSTMENT</b>	
(75) Inventor: <b>Rodney H. Ottoman, Aloha, OR (US)</b>	
(73) Assignee: <b>Leupold &amp; Stevens, Inc., Beaverton, OR (US)</b>	
(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.	
(21) Appl. No.: <b>09/494,983</b>	
(22) Filed: <b>Jan. 31, 2000</b>	
(51) Int. Cl. <sup>7</sup> : <b>F41G 1/00</b>	
(52) U.S. Cl.: <b>42/120</b>	
(58) Field of Search: <b>33/245-250; 350-549; 350-603; 350/247; 350/187; 42/122</b>	
(56) References Cited	
U.S. PATENT DOCUMENTS 2,585,042 A * 1/1952 Desros ..... 33/246 2,811,894 A * 11/1957 Baker ..... 33/246 3,066,780 A * 7/1963 Matis ..... 34/167 3,625,844 A 10/1972 Pillal et al. .... 39/48 3,760,591 A 10/1973 Noppe ..... 350/252 3,950,720 A 1/1976 Givens ..... 350/187 4,140,505 A 12/1978 Sakaguchi et al. .... 354/197 4,180,041 A * 3/1978 Alexander et al. .... 350/76 4,247,091 A 1/1981 Ueff, Jr ..... 33/246 4,640,542 A 2/1987 Gibson ..... 350/567 4,998,832 A * 5/1991 Bana ..... 350/560 5,020,892 A * 9/1991 Glover et al. .... 350/537 5,113,261 A * 9/1992 Moriawa ..... 350/225	
FOREIGN PATENT DOCUMENTS DE 297,207 T1 3/1998 * cited by examiner	
Primary Examiner—Michael J. Carone Assistant Examiner—Dennis J. Buckley (74) Attorney, Agent, or Firm—Stoel Rives LLP	
(57) <b>ABSTRACT</b> A focus adjustment mechanism for a telescopic rifle sight includes a rotatable cam hub including a drive face and a spiral cam track formed in the drive face around an axis of rotation. An actuator slide of the adjustment mechanism is slidably mounted to a housing of the telescopic rifle sight for movement along a longitudinal axis of the housing. The actuator slide includes a cam follower that is operably engaged in the spiral cam track so that the actuator slide moves generally along the longitudinal axis in response to rotation of the cam hub in changing a setting of the adjustment mechanism. The actuator slide is operatively connected to a movable optical element positioned within the housing of the telescopic rifle sight to direct the optical element in response to rotation of the cam hub. The rate of linear movement of the optical element relative to the rate of rotation of the cam hub is controlled by the slope and arcuate angle of the spiral cam track. A spring biases the actuator slide relative to the housing to prevent rifle recoil from inducing changes to the setting of the adjustment mechanism.	
20 Claims, 5 Drawing Sheets	
	

Col. 3, ll. 28-36; Col. 5 ll. 50-67; Fig. 6B.

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 **STOEL RIVES LLP**

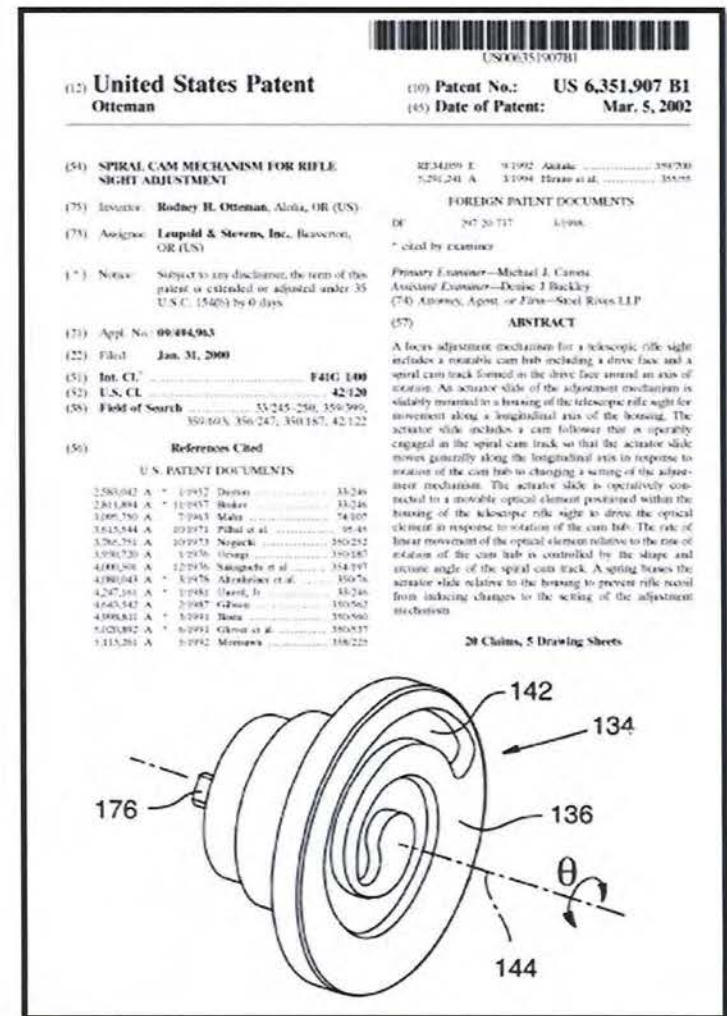
Exhibit 1- Leupold & Stevens  
 Notice Filing Markman Hearing Presentation Materials  
 Page 20 of 82



# DESCRIPTION IN THE SPECIFICATION

The focus control knob of the present invention includes a cam hub mounted to the housing for rotation about an axis of rotation. The cam hub includes a drive face positioned facing the interior of the housing and a spiral cam track formed in the drive face around the axis of rotation and spiraling outwardly from the axis of rotation. An actuator

within a guide slot 128 of housing 12. Guide slot 128 is oriented generally parallel to longitudinal axis 14 of housing 12. A cam hub 134 is rotatably mounted to housing 12 so that actuator 122 is slidably captured between housing 12 and a drive face 136 of cam hub 134. FIGS. 6A and 6B are respective enlarged top and bottom perspective views of cam hub 134 showing detail of drive face 136. With reference to FIGS. 4, 5, 6A, and 6B, a cam follower pin 140 of actuator 122 extends into and is guided by a spiral cam groove 142 formed in drive face 136. Rotation of cam hub 134 about its axis of rotation 144 drives actuator 122 along guide slot 128, which in turn moves movable objective lens portion 26 along longitudinal axis 14 to adjust the focus of sight 10. The size of spiral cam groove 142 determines the amount of travel of actuator 122 and objective lens portion 26. The size of spiral cam groove 142 is limited only by the diameter of drive face 136. Cam hub 134 is preferably molded of a plastic resin, such as, for example, nylon, for

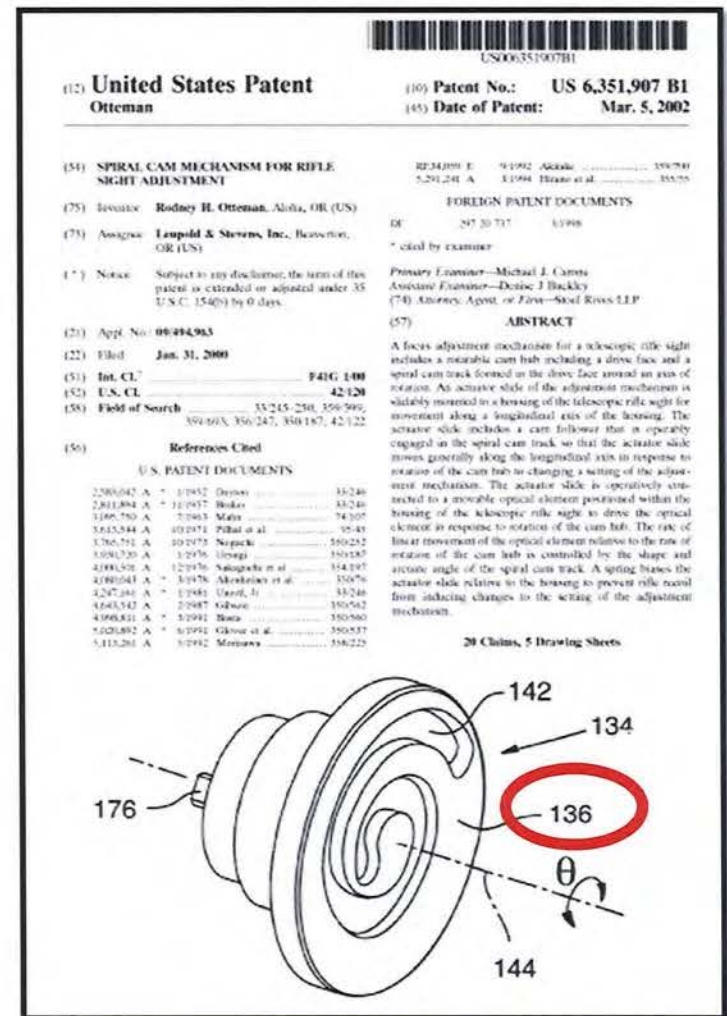




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The focus control knob of the present invention includes a cam hub mounted to the housing for rotation about an axis of rotation. The cam hub includes a drive face positioned facing the interior of the housing and a spiral cam track formed in the drive face around the axis of rotation and spiraling outwardly from the axis of rotation. An actuator

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## Leupold:

- A surface in which the cam track is formed

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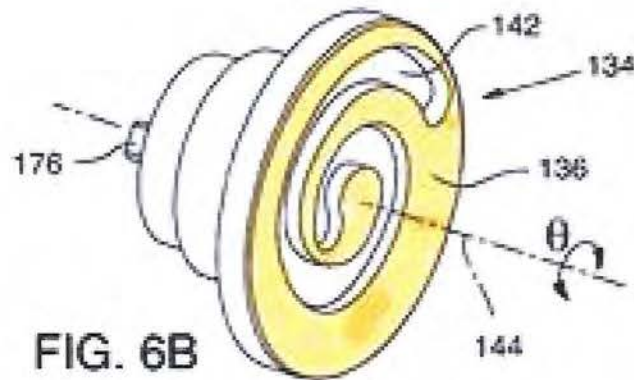
### Nightforce:

- The face of a cam hub that contacts and drives an actuator positioned between the cam hub and a housing of a rifle sight.

# THE PARTIES' DIFFERING CONSTRUCTIONS:

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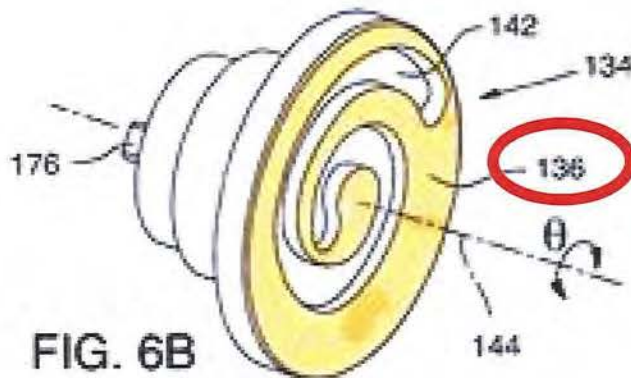
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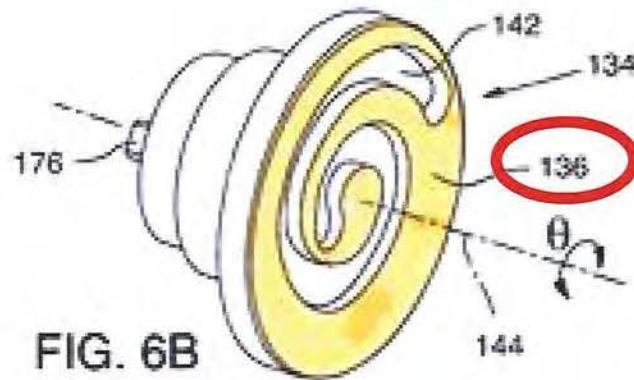
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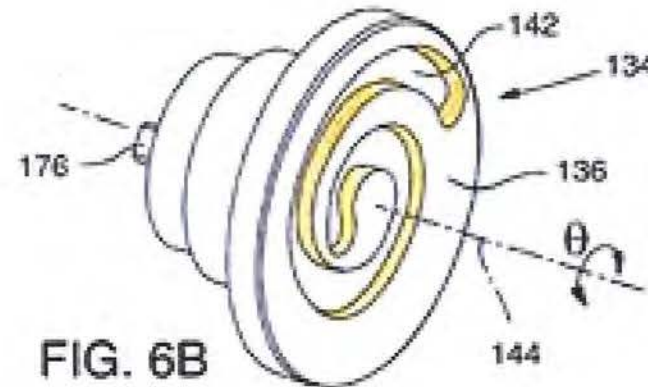
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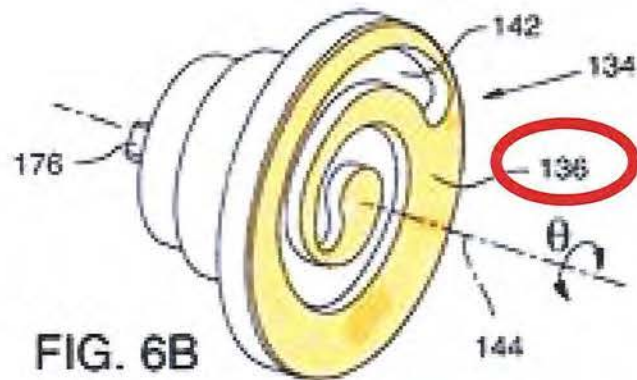
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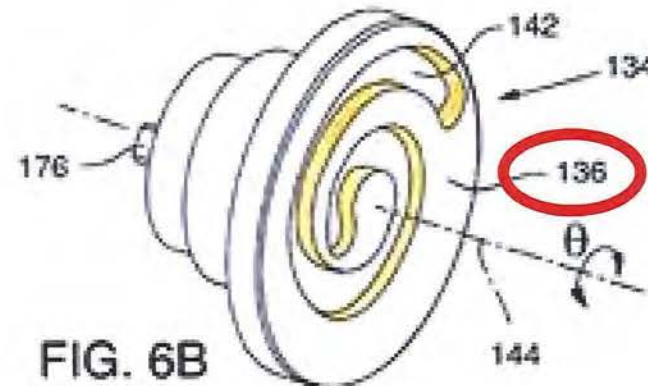
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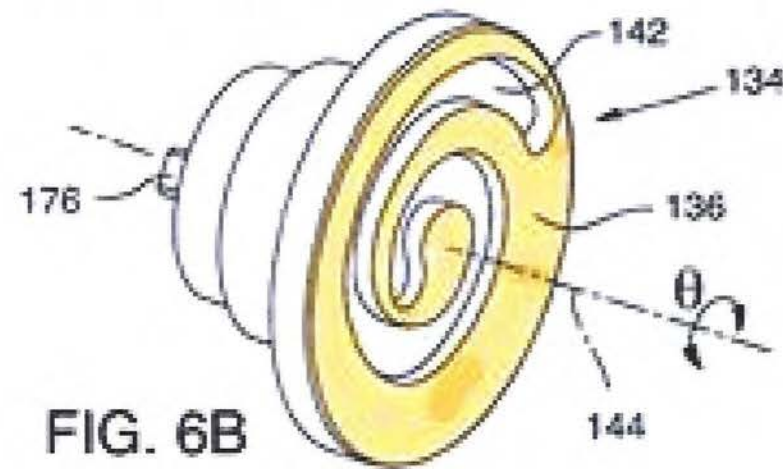


## Nightforce:

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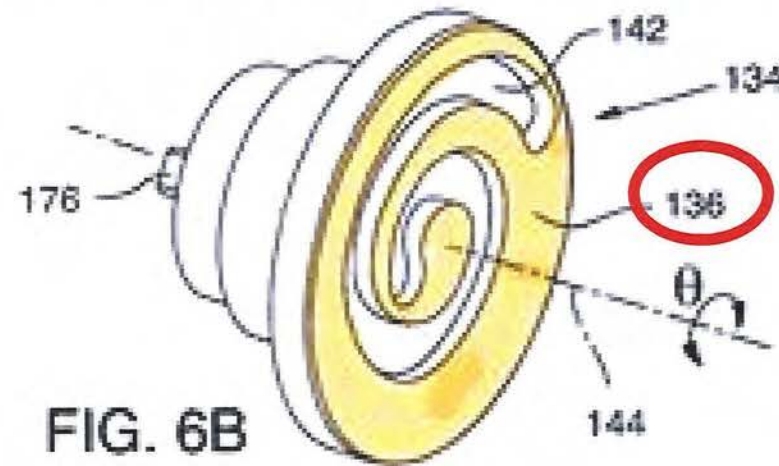


## FIG. 5 Is CONSISTENT WITH FIG. 6B:

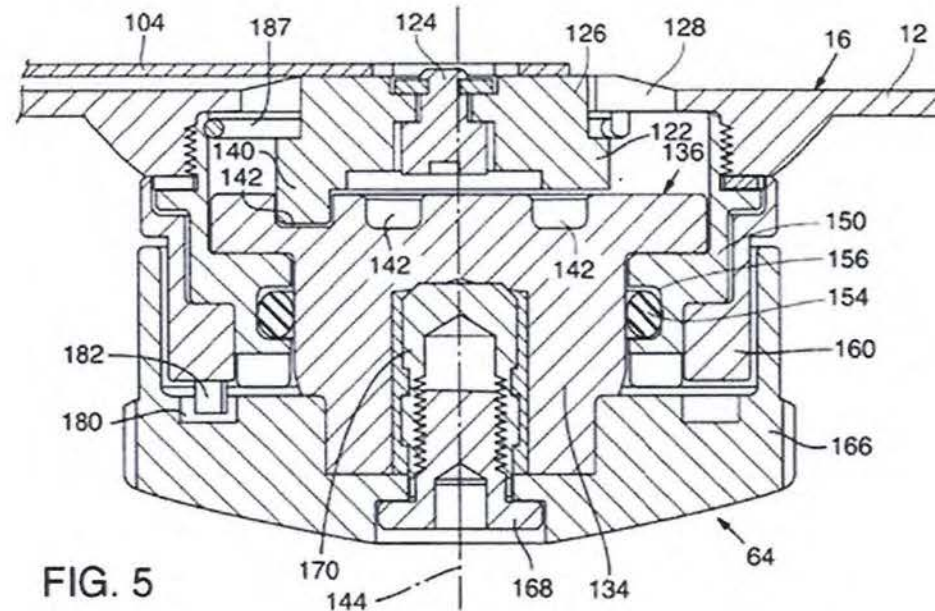
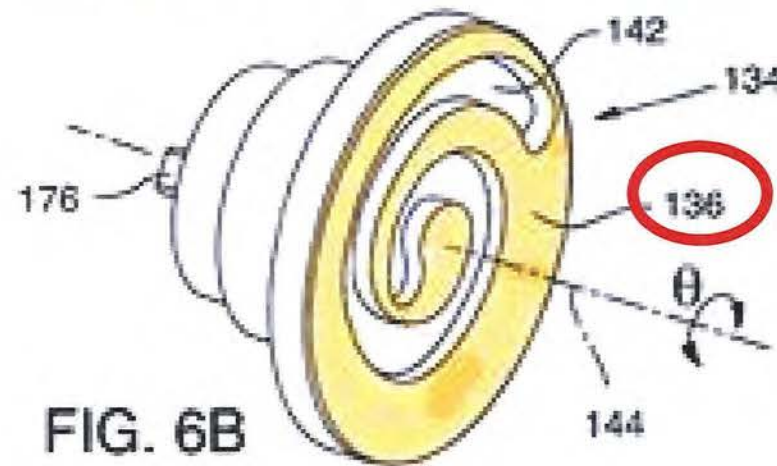




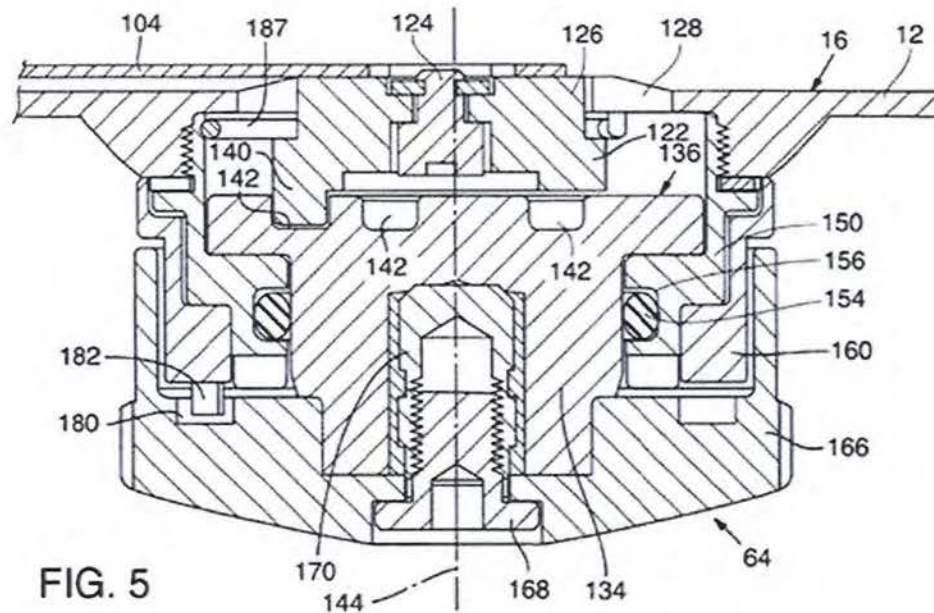
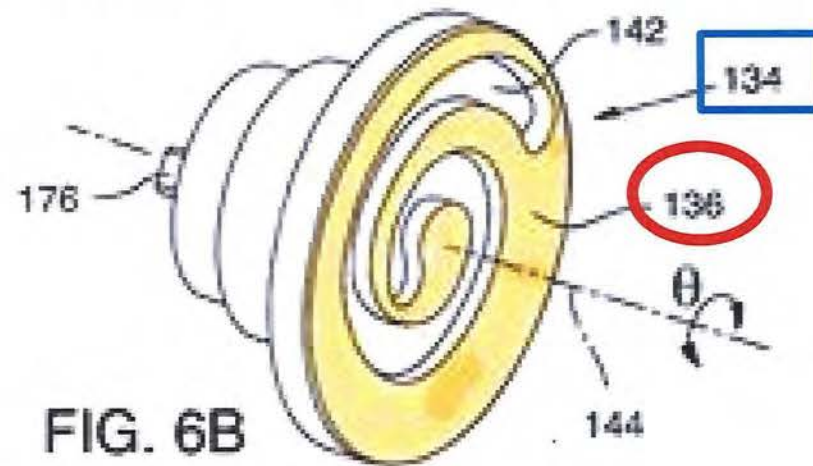
## FIG. 5 Is CONSISTENT WITH FIG. 6B:



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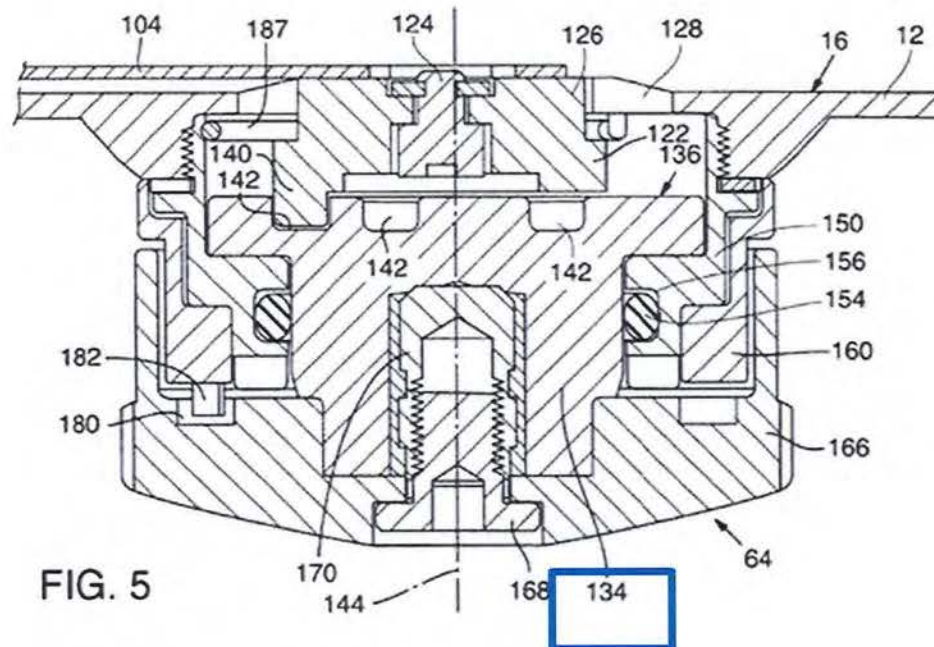
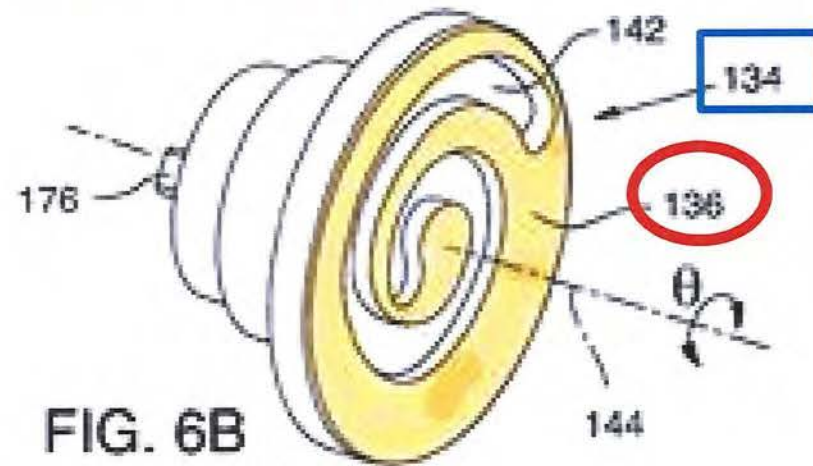


# FIG. 5 IS CONSISTENT WITH FIG. 6B:

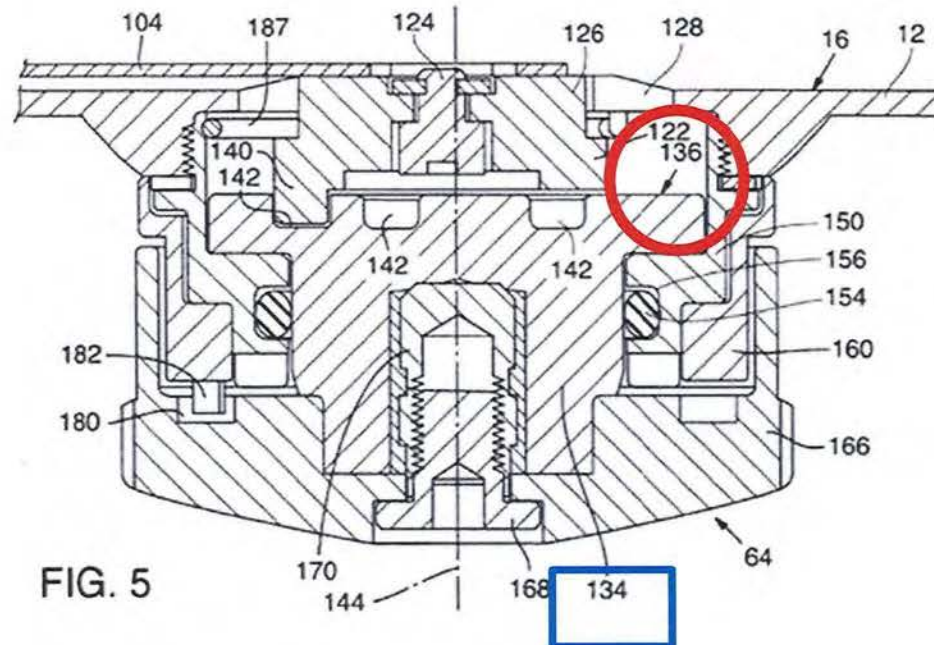
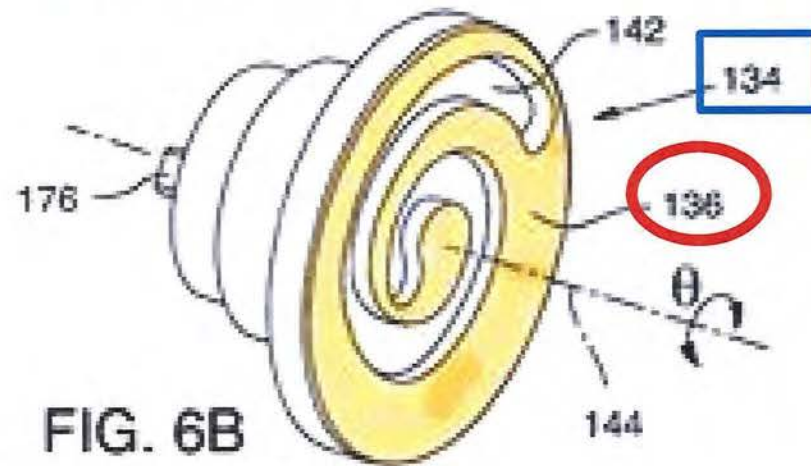




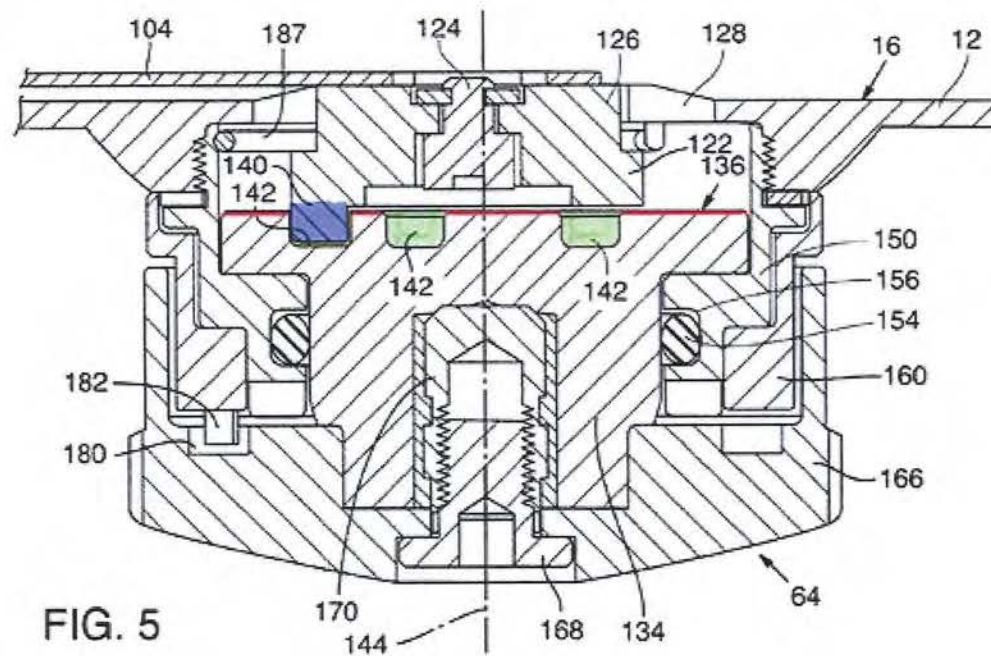
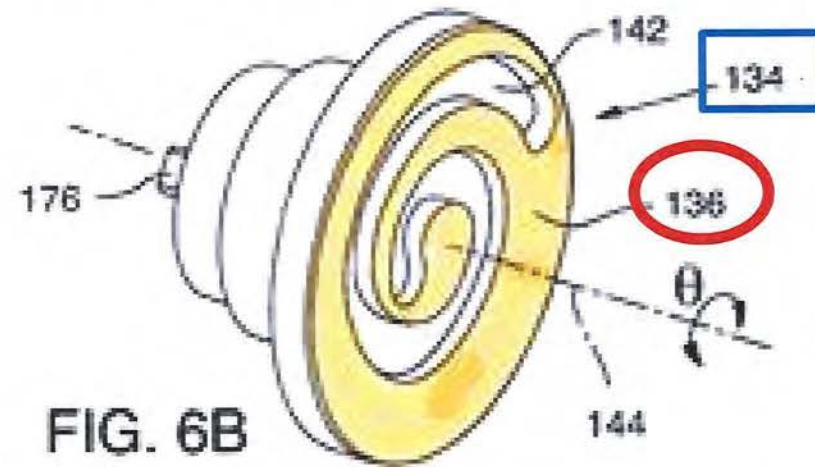
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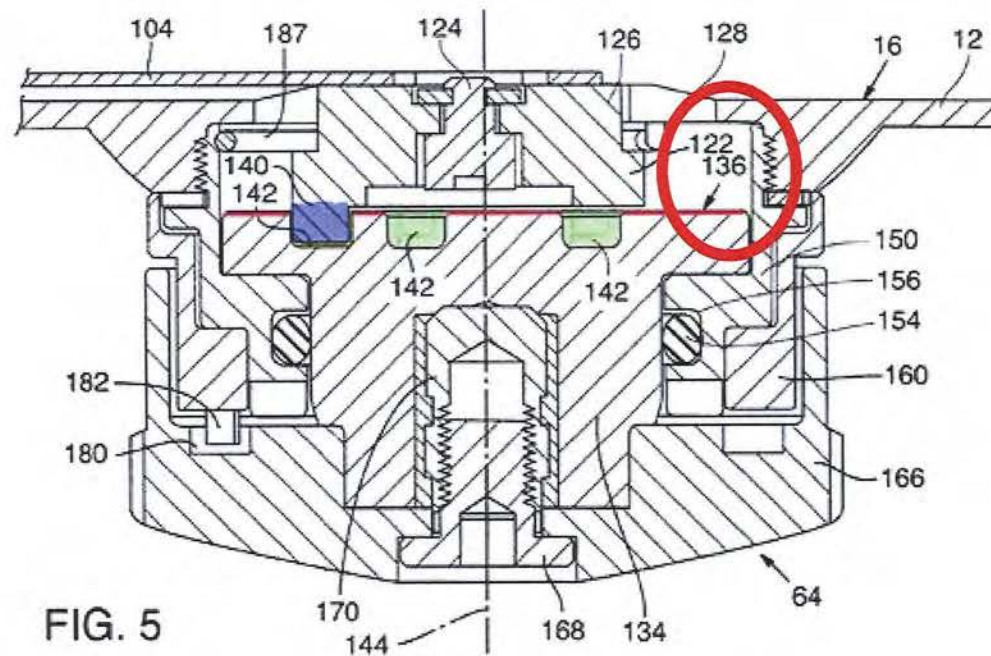
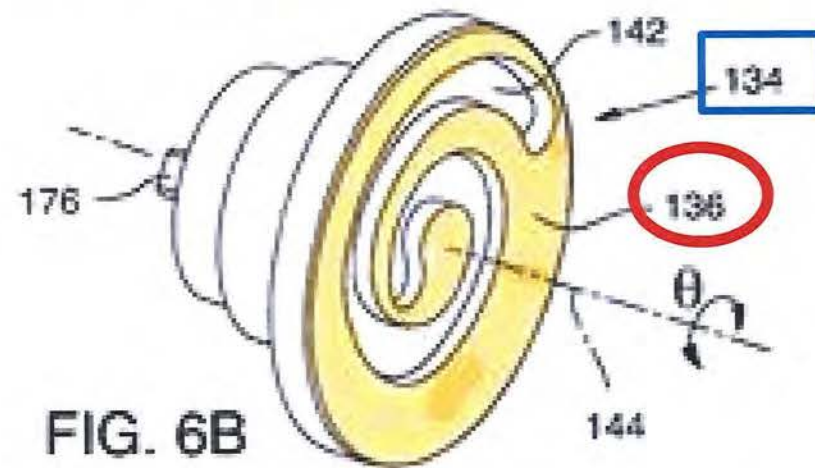


# FIG. 5 IS CONSISTENT WITH FIG. 6B:





# FIG. 5 IS CONSISTENT WITH FIG. 6B:



# “Cam Track”

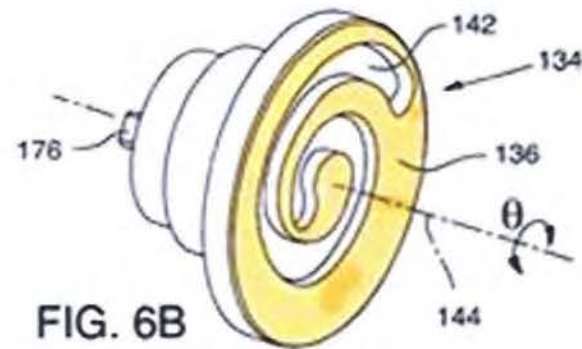
# CLAIM LANGUAGE IS DETERMINATIVE

- Language of claims does not extend to alternative embodiments taught in specification. Claims limited to “cam track” that is a groove, not a rail.



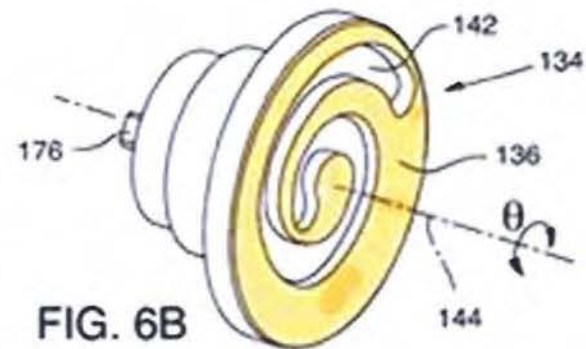
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136 = “Drive Face”

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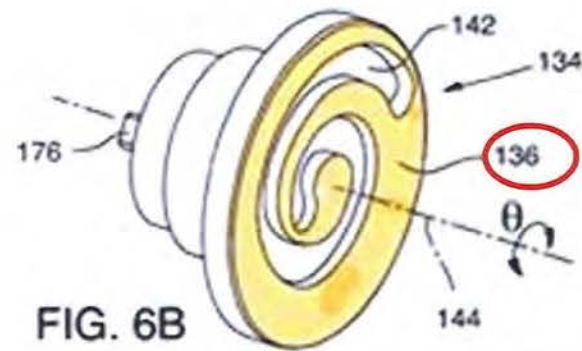


FIG. 6B

136 = “Drive Face”



# CLAIM LANGUAGE IS DETERMINATIVE

- Language of claims does not extend to alternative embodiments taught in specification. Claims limited to “cam track” that is a groove, not a rail.

1. An adjustment mechanism for a telescopic rifle sight of the type including an elongate tubular housing having a longitudinal axis and a movable optical element mounted within the housing, comprising:

a cam hub mounted to the housing for rotation about an axis of rotation, the cam hub positioned so that the axis of rotation is substantially perpendicular to the longitudinal axis, the cam hub including a drive face and a spiral cam track formed in the drive face around the axis of rotation; and

an actuator slidably mounted for movement along the longitudinal axis of the housing and including a cam follower operably engaged in the spiral cam track so that the actuator moves generally along the longitudinal axis in response to rotation of the cam hub, the actuator operatively connected to the optical element to drive the optical element in response to rotation of the cam hub.

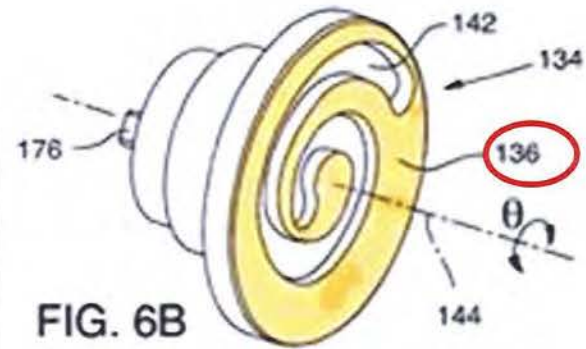


FIG. 6B

136 = “Drive Face”

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a cam hub mounted to the housing for rotation about an axis of rotation, the cam hub positioned so that the axis of rotation is substantially perpendicular to the longitudinal axis, the cam hub including a drive face and a spiral cam track formed in the drive face around the axis of rotation; and

an actuator slidably mounted for movement along the longitudinal axis of the housing and including a cam follower operably engaged in the spiral cam track so that the actuator moves generally along the longitudinal axis in response to rotation of the cam hub, the actuator operatively connected to the optical element to drive the optical element in response to rotation of the cam hub.

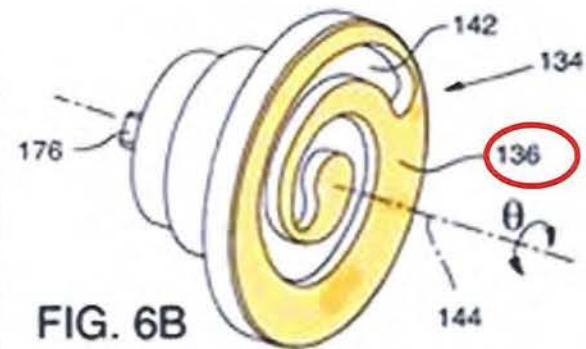


FIG. 6B

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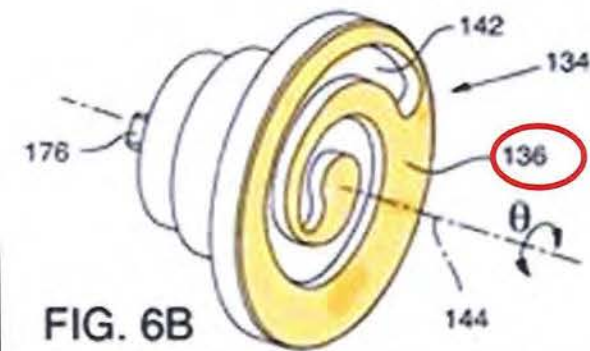


FIG. 6B

136 = “Drive Face”



# CLAIM DIFFERENTIATION

- Claim 6 is narrower than Claim 1 because Claim 6 requires “cam follower” to include a “pin.”

6. The adjustment mechanism of claim 1 in which the spiral cam track includes a spiral groove and in which the cam follower includes a pin.

- “Claim differentiation” doctrine does not apply where some other claim element (here, pin) makes the dependent claim narrower than the independent claim.
  - See NF Response (Dkt. 58 at 22 n.13.)

# “Actuator”

## LEGAL PRESUMPTION *AGAINST* §112 ¶6

- Where patentee has not elected means-plus-function treatment by using triggering language (“means” or “means for”) presumption that §112 ¶6 DOES NOT apply.
- To overcome the presumption Nightforce must show that the claim limitation is only a **function**, without reference to **structure**.



# LEGAL PRESUMPTION

- Where patentee has not function treatment by use (“means” or “means for”) ¶6 DOES NOT apply.
- To overcome the presumption show that the claim limitation without reference to **structure**

Williamson v. Citrix Online, LLC, 792 F.3d 1339 (2015)  
115 U.S.P.Q.2d 1106

**KeyCite Yellow Flag - Negative Treatment**  
Declined to Extend by Reynolds, LLC v. Certified Aviation Services, LLC, C.D. Cal., May 18, 2017

792 F.3d 1339  
United States Court of Appeals,  
Federal Circuit.

Richard A. WILLIAMSON, Trustee for at Home Bondholders Liquidating Trust, Plaintiff-Appellant  
v.  
CITRIX ONLINE, LLC, Citrix Systems, Inc., Microsoft Corporation, Adobe Systems, Inc., Defendants-Appellees  
Webex Communications, Inc., Cisco Webex, LLC, Cisco Systems, Inc., Defendants-Appellees  
International Business Machines Corporation, Defendant-Appellee.

No. 2013-1130.  
June 16, 2015.

## Synopsis

**Background:** Patentee brought action alleging infringement of patent for system and method of distributed learning. The United States District Court for the Central District of California, A. Howard Mays, J., entered stipulated judgment in alleged infringers' favor, and patentee appealed.

**Holdings:** The Court of Appeals, Linn, Circuit Judge, held that:

[1] claims requiring “graphical display” representative of classroom did not require pictorial map that identified participants’ location;

[2] presumption that the means-plus-function statute does not apply to a patent claim that does not use the word “means” is not strong, overruling Lighting World, Inc. v. Birchwood Lighting, Inc., 382 F.3d 1354, Inventio AG v. ThyssenKrupp Elevator Americas Corp., 649 F.3d 1350, Flo Healthcare Solutions, LLC v. Kappas, 697 F.3d 1367, Apple Inc. v. Motorola, Inc., 757 F.3d 1286;

[3] term “distributed learning control module,” as used in patent was means-plus-function claim term; and

[4] specification did not disclose sufficient structure corresponding to the “distributed learning control module” referred to in means-plus-function claims, making those claims invalid for indefiniteness.

Affirmed in part, vacated in part, and remanded.

Reyna, Circuit Judge, filed opinion concurring in part and dissenting in part.

Opinion, 770 F.3d 1371, superseded on rehearing.

West Headnotes (21)

## [1] Patents

### Construction and Operation of Patents

District court’s claim construction determinations based on evidence intrinsic to the patent as well as its ultimate interpretations of the patent claims are legal questions reviewed de novo.

4 Cases that cite this headnote

## [2] Patents

### Construction and Operation of Patents

To the extent the district court, in construing patent claims, makes underlying findings of fact based on extrinsic evidence, the Court of Appeals reviews such findings of fact for clear error.

3 Cases that cite this headnote

## [3] Patents

### Business methods/Internet applications

Claims in patent for system and method of distributed learning requiring “graphical display” representative of classroom did not require pictorial map that identified participants’ location, even though specification disclosed examples and

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# LEGAL PRESUMPTION

- Where patentee has not function treatment by use (“means”)
- ¶6 DOES
- To overcome show the without

for structure. Greenberg, 91 F.3d at 1583. When a claim term lacks the word “means,” the presumption can be overcome and § 112, para. 6 will apply if the challenger demonstrates that the claim term fails to “recite sufficiently definite structure” or else recites “function without reciting sufficient structure for performing that function.” Watts, 232 F.3d at 880. The converse presumption remains unaffected: “use of the word ‘means’ creates a presumption that § 112, ¶ 6 applies.” Personalized Media, 161 F.3d at 703.

Williamson v. Citrix Online, LLC, 792 F.3d 1339 (2015)  
115 U.S.P.Q.2d 1105

KeyCite Yellow Flag - Negative Treatment  
Decided to Extend by Reynolds, LLC v. Certified Aviation Services, LLC, C.D.Cal., May 18, 2017  
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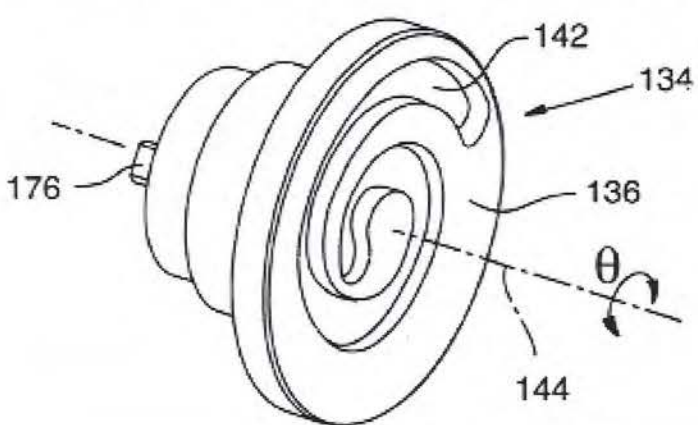
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WESTLAW © 2018 Thomson Reuters. No claim to original U.S. Government Works.



# ACTUATOR: CLAIM LANGUAGE CONTEXT

 US006351907B1	
<b>(12) United States Patent</b> <b>Ottoman</b>	
<b>(10) Patent No.: US 6,351,907 B1</b> <b>(45) Date of Patent: Mar. 5, 2002</b>	
<b>(54) SPIRAL CAM MECHANISM FOR RIFLE SIGHT ADJUSTMENT</b>	
<b>(75) Inventor: Rodney H. Ottoman, Aloha, OR (US)</b>	
<b>(73) Assignee: Leupold &amp; Stevens, Inc., Beaverton, OR (US)</b>	
<b>(*) Notice:</b> Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.	
<b>(23) Appl. No.: 09/494,983</b> <b>(22) Filed: Jan. 31, 2000</b>	
<b>(51) Int. Cl.:</b> F41G 1/00 <b>(52) U.S. Cl.:</b> 42/120 <b>(58) Field of Search:</b> 35/245, 250, 359/309, 359/403, 359/247, 359/187, 42/122	
<b>(56) References Cited</b> <b>U.S. PATENT DOCUMENTS</b>	
2,585,042 A * 1/1952 Dayton ..... 33/246 2,811,894 A * 11/1957 Baker ..... 33/246 3,095,750 A * 7/1963 Maho ..... 74/107 3,415,544 A * 10/1971 Pihai et al. .... 35/48 3,765,751 A * 10/1973 Naguchi ..... 35/252 3,990,720 A * 1/1976 Ueogi ..... 35/187 4,000,508 A * 12/1976 Sakaguchi et al. .... 35/197 4,080,043 A * 3/1978 Altshuler et al. .... 35/176 4,247,191 A * 1/1983 Ueoff, Jr. .... 33/246 4,643,547 A * 2/1987 Gilson ..... 35/567 4,998,811 A * 3/1991 Hara ..... 35/560 5,020,892 A * 6/1991 Glover et al. .... 35/537 5,113,201 A * 8/1992 Moriawa ..... 35/225	
<b>FOREIGN PATENT DOCUMENTS</b> DE 297 20 737 3-1948 * cited by examiner	
<b>Primary Examiner—Michael J. Carone</b> <b>Assistant Examiner—Debbie J. Buckley</b> <b>(74) Attorney, Agent, or Firm—Steel Rives LLP</b>	
<b>(57) ABSTRACT</b> A focus adjustment mechanism for a telescopic rifle sight includes a rotatable cam hub including a drive face and a spiral cam track formed in the drive face around an axis of rotation. An actuator slide of the adjustment mechanism is slidably mounted to a housing of the telescopic rifle sight for movement along a longitudinal axis of the housing. The actuator slide includes a cam follower that is operably engaged in the spiral cam track so that the actuator slide moves generally along the longitudinal axis in response to rotation of the cam hub in changing a setting of the adjustment mechanism. The actuator slide is operatively connected to a movable optical element positioned within the housing of the telescopic rifle sight to drive the optical element in response to rotation of the cam hub. The rate of linear movement of the optical element relative to the rate of rotation of the cam hub is controlled by the shape and arcuate angle of the spiral cam track. A spring biases the actuator slide relative to the housing to prevent rifle recoil from inducing changes to the setting of the adjustment mechanism.	
<b>20 Claims, 5 Drawing Sheets</b>	
	



# ACTUATOR: CLAIM LANGUAGE CONTEXT

(12) United States Patent  
Otteman



US006351907B1

(10) Patent No.: US 6,351,907 B1  
(45) Date of Patent: Mar. 5, 2002

1. An adjustment mechanism for a telescopic rifle sight of the type including an elongate tubular housing having a longitudinal axis and a movable optical element mounted within the housing, comprising: 10

a cam hub mounted to the housing for rotation about an axis of rotation, the cam hub positioned so that the axis of rotation is substantially perpendicular to the longitudinal axis, the cam hub including a drive face and a spiral cam track formed in the drive face around the axis of rotation; and 15

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US0006351907B1

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## STRUCTURES WITH FUNCTIONAL NAMES

- *Greenberg v. Ethicon Endo-Surgery* (Fed. Cir. 1996)
  - [T]he fact that a particular mechanism—here “detent mechanism”—is defined in functional terms is not sufficient to . . . [invoke] section 112(6). Many devices take their name from the functions they perform. The examples are innumerable, such as “filter,” “brake,” “clamp,” “screwdriver,” or “lock.” Indeed, several of the devices at issue in this case have names that describe their functions, such as “graspers,” “cutters,” and “suture applicators.”

## CASES FINDING §112 ¶6 INAPPLICABLE:

- “Acutator” is not subject to §112 ¶6:
  - ***Intelligent Water Solutions, LLC v. Kohler Co.***, 2017 WL 2444723, at \*18-19 (E.D.Tex. Jun. 5, 2017)
- *See also*:
  - ***Sunrace Roots v. SRAM Corp.***, 336 F.3d 1298 (Fed. Cir. 2003) (affirming refusal to construe “shift actuator” more narrowly than ordinary meaning; finding term had ordinary meaning referring to structures that control changing of gears)



# CASES FINDING §112 ¶6 INAPPLICABLE

- “Actuator” is not subject  
– *Intelligent Water Solutions v. Kohler Co.*  
2017 WL 2444723, at \*1
- See also:  
– *Sunrace Roots v. SRA*  
(Fed. Cir. 2003) (affirming  
“actuator” more narrowly  
finding term had ordinary  
structures that control

Intelligent Water Solutions, LLC v. Kohler Co., Slip Copy (2017)

2017 Markman 2444723

2017 WL 2444723  
United States District Court,  
E.D. Texas, Marshall Division.

INTELLIGENT WATER  
SOLUTIONS, LLC, Plaintiff,  
v.  
KOHLER CO., Defendant.

CASE NO. 2:16-CV-689

Signed 06/05/2017

Go to Markman Constructed Terms

## Attorneys and Law Firms

Jay D. Ellwanger, Andrew Gerald Dinovo, Daniel Louis Schmid, Dinovo Price Ellwanger & Hardy LLP, Austin, TX, Shawn A. Latchford, Eric M. Albritton, Albritton Law Firm, Longview, TX, for Plaintiff.

Arthur Gollwitzer, III, Michael Best & Friedrich LLP, Austin, TX, Rachel N. Bach, Michael Best & Friedrich, LLP, Milwaukee, WI, for Defendant.

## MEMORANDUM OPINION AND ORDER

ROY S. PAYNE, UNITED STATES MAGISTRATE  
JUDGE

\*1 Before the Court is the opening claim construction brief of Plaintiff Intelligent Water Solutions, LLC. (“Plaintiff”) (Dkt. No. 55, filed on April 12, 2017), the response of Defendant Kohler Co. (“Defendant”) (Dkt. No. 57, filed on April 26, 2017), and the reply of Plaintiff (Dkt. No. 59, filed on May 3, 2017). The Court held a claim construction hearing on May 24, 2017. Having considered the arguments and evidence presented by the parties, the Court issues this Claim Construction Order.

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## I. BACKGROUND.....

## II. LEGAL PRINCIPLES.....

## III. CONSTRUCTION OF AGREED TERMS.....

## IV. CONSTRUCTION OF DISPUTED TERMS.....

A. “system control means”.....

B. “microprocessor”.....

C. “programmable digital processor”.....

D. “remote system monitoring / control device”.....

E. “fluid supply control valve” and “fluid control valve”.....

F. “fluid supply control valve actuator” and “fluid control valve actuator”.....

G. “external data storage and input means”.....

H. “memory means”.....

I. “domestic water supply system”.....

J. “user interface input”.....

## V. CONCLUSION.....

## I. BACKGROUND

Plaintiff brings suit alleging infringement of United States Patent No. 6,286,764 (“the ‘764 patent” or “patent-in-suit”) by the Defendant.

The application leading to the ‘764 patent was filed on July 14, 1999 and issued on September 11, 2001. The ‘764 patent is entitled “Fluid and Gas Supply System.” In general, the ‘764 patent is directed to a fluid or gas delivery system that controls temperature, flow rate, and volume at a system outlet by controlling/regulating valves and/or flows. The Abstract of the ‘764 patent states:

A fluid or gas delivery system is provided for controlling fluid or gas temperature, flow rate and volume at a system outlet. The system comprises single or double control valves for regulating flow of a first fluid or gas and a second fluid or



Here, the disputed term does not recite the word “means.” Therefore, there is a rebuttable presumption that § 112, ¶ 6 does not apply. While the Defendant argues that the use of the term “**actuator**” is a nonce term, the Court disagrees. The term “**actuator**” is not a nonce term, such as the generic terms “mechanism,” “element,” “device,” and similar nonce words. Thus, there is a presumption that this term is not a **means-plus-function** limitation. And as detailed below, Defendant has failed to rebut the presumption because “the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite **meaning** as the name for structure.” *Williamson*, 792 F.3d at 1348. Overall, the Court finds that the disputed “**actuator**” terms provide sufficiently definite structure given the context of the limitations in which the claim terms are found.

As provided by the Plaintiff, “**actuator**” is a well known word and is defined in the Dictionary of Mechanical Engineering as “[a]n electric, hydraulic, mechanical or pneumatic device, or combination of these to effect some predetermined linear or rotating movement.” The fact that a technical dictionary, which is evidence of the understandings of persons of skill in the art, provides a **meaning** to the “**actuator**” term plainly indicates that the term “**actuator**” connotes structure. *See Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1320 (Fed. Cir. 2004) (finding structure for the term “circuit” based at least in part on “circuit” being defined in a technical

Intelligent Water Solutions, LLC v. Kohler Co., 58p Copy (2017)  
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#### Go to Markman Constructed Terms

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#### MEMORANDUM OPINION AND ORDER

ROY S. PAYNE, UNITED STATES MAGISTRATE  
JUDGE

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F. “fluid supply control valve **actuator** ...” and “fluid control valve **actuator** ...”.....

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As provided by the Plaintiff, “actuator” is a well known word and is defined in the Dictionary of Mechanical Engineering as “[a]n electric, hydraulic, mechanical or pneumatic device, or combination of these to effect some predetermined linear or rotating movement.” The fact that a technical dictionary, which is evidence of the understandings of persons of skill in the art, provides a meaning to the “actuator” term plainly indicates that the term “actuator” connotes structure. *See Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1320 (Fed. Cir. 2004) (finding structure for the term “circuit” based at least in part on “circuit” being defined in a technical

dictionary). Far from being a placeholder, “actuator” defines a class of structures to a person of ordinary skill. “[I]t is sufficient if the claim term is used in common parlance or by persons of skill in the pertinent art to designate structure, even if the term covers a broad class of structures and even if the term identifies the structures by their function.” *TecSec*, 731 F.3d at 1347 (citing *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1359-60 (Fed. Cir. 2004)).

\*19 Consistent with this understanding, the specification provides an example of the actuator means as being any electric, pneumatic, hydraulic, or magnetically driven motor, or solenoid, as well as a stepper motor. *See, e.g.*, '764 patent, col. 5, ll. 34-66; col. 8, ll. 14-21; col. 16, ll. 10-12. Further, the claim terms provide meaningful context and describe how the “actuator” interacts with other components. For example, the “flow control valve actuator” is “operatively connected to said flow control valve for actuating opening and closure operations thereof.” Similarly, the “fluid supply control actuator” is “operatively connected to said fluid supply valve for actuating opening and closure operations thereof.” The Court finds that the Defendant has not rebutted the presumption that the term is not a means-plus-function

considered the arguments and evidence presented by the parties, the Court issues this Claim Construction Order.

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#### I. BACKGROUND.....

A fluid or gas delivery system is provided for controlling fluid or gas temperature, flow rate and volume at a system outlet. The system comprises single or double control valves for regulating flow of a first fluid or gas and a second fluid or



Here, the disputed term does not recite the word “means.” Therefore, there is a rebuttable presumption that § 112, ¶ 6 does not apply. While the Defendant argues that the use of the term “actuator” is a nonce term, the Court disagrees. The term “actuator” is not a nonce term, such as the generic terms “mechanism” and similar nonce words. Thus, that this term is not a **means** term. And as detailed below, Defendant rejects the presumption because “the term is understood by persons of ordinary skill in the art to have a sufficiently definite meaning.” *Williamson*, 792 F.3d at 1348. On the other hand, the disputed “actuator” terms provide structure given the context of the claim terms are found.

As provided by the Plaintiff, “actuator” is a word and is defined in the Dictionary of Mechanical Engineering as “[a]n electric, pneumatic device, or combination thereof, for producing predetermined linear or rotational motion.” That a technical dictionary, which provides understandings of persons of skill in the art, provides a meaning to the “actuator” term plainly indicates that the term “actuator” connotes structure. *See Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1320 (Fed. Cir. 2004) (finding structure for the term “circuit” based at least in part on “circuit” being defined in a technical

limitation. On balance, the Plaintiff has persuasively demonstrated that the disputed term refers to a particular class of structures and/or that the disputed term's use of the word “actuator” (along with other limitations) is structural rather than functional. Thus, the term is a not **means-plus-function** limitation governed by 35 U.S.C § 112, ¶ 6.

One of ordinary skill in the art, based upon the specification and the claims, would understand the disputed terms to have their plain and ordinary meaning. The Court rejects Defendants' arguments to the contrary. No further clarification of the terms is necessary. Because this resolves the dispute between the parties, the Court finds that the term requires no further construction.

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347 (citing *Lighting* *etc.*, 382 F.3d 1354,

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#### I. BACKGROUND.---

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## REJECTING §112 ¶6 IS SUFFICIENT TO RESOLVE THE PARTIES' DISPUTE

- NF's case involves a very different situation
  - ***Eon Corp. IP Holdings LLC v. Silver Spring Network***, 815 F.3d 1314 (Fed. Cir. 2016)
- ***Summit 6, LLC v. Samsung Elecs. Co.***, 802 F.3d 1283, 1291 (Fed. Cir. 2015)
- ***Finjan, Inc. v. Secure Computing Corp.***, 626 F.3d 1197, 1206–07 (Fed. Cir. 2010)

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**Finjan, Inc. v. Secure Computing Corp.**, 626 F.3d 1197 (2010)  
87 U.S.P.Q.2d 1161

**KeyCite Yellow Flag - Negative Treatment**  
Decided to extend by *Torsten, Inc. v. Adolph, E.D. Va.*, November 24, 2015

626 F.3d 1197  
United States Court of Appeals,  
Federal Circuit.

FINJAN, INC. (Formerly Finjan Software, Ltd.), Plaintiff-Cross Appellant,  
v.  
SECURE COMPUTING CORPORATION, Cyberguard Corporation, and Webwasher AG, Defendants-Appellants,  
and  
Does 1 through 100, Defendants.

No. 2009-1576, 2009-1594  
Nov. 4, 2010.  
Rehearing and Rehearing En Banc Denied May 26, 2011.

**Synopsis**  
**Background:** Patentee brought action against competitor, alleging infringement of patents directed to "proactive scanning" technology for computer security. Competitor counterclaimed for infringement of its own patents. Following jury trial, the United States District Court for the District of Delaware, Gregory M. Sleet, Chief Judge, entered judgment in favor of patentee, and subsequently, 2009 WL 2524495, granted in part and denied in part parties' post-trial motions. Competitor appealed and patentee cross-appealed.

**Holding:** The Court of Appeals, Linn, Circuit Judge, held that:

[1] patentee's failure to allege indirect or joint infringement was not fatal to its claim that competitor infringed patents' "system" and "storage medium" claims;

[2] evidence was insufficient to demonstrate competitor directly infringed patents' method claims in United States;

[3] district court was not required to provide additional guidance to jury on construction of claim term construed to have its plain and ordinary meaning;

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Affirmed in part, reversed in part, and remanded.

**Attorneys and Law Firms**

\*1200 Daryl L. Joseffer, King & Spalding LLP, of Washington, DC, argued for plaintiff-cross appellant. With him on the brief were Paul D. Clement; Paul J. Andre, Lisa Kobialka, of Redwood Shores, CA; and Adam Conrad, of Charlotte, NC.

David J. Healey, Fish & Richardson P.C., of Houston, TX, argued for defendants-appellants. With him on the brief was Justin M. Barnes, of San Diego, CA. Of counsel on the brief were Ronald J. Schutz, Jacob M. Holdreith, Christopher A. Seidl, and Trevor J. Foster, Robins, Kaplan, Miller & Ciresi LLP, of Minneapolis, MN. Of counsel was Benjamin C. Elacqua.

Before NEWMAN, GAJARSA, and LINN, Circuit Judges.

**Opinion**  
LINN, Circuit Judge.

This is a patent infringement case involving "proactive scanning" technology for computer security. Finjan, Inc. sued Secure Computing Corporation ("Secure"), Cyberguard Corporation, and Webwasher AG (collectively "Defendants") in the District Court for the District of Delaware for infringement of U.S. Patents No. 6,092,194 ("#194 patent"), No. 6,804,780 ("#780 patent"), and No. 7,058,822 ("#822 patent"). Defendants

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# REJECTING §112 ¶6 IS SUFFICIENT TO RESOLVE THE PARTIES' DISPUTE

No such error happened here. Unlike *O2 Micro*, where the court failed to resolve the parties' quarrel, the district court rejected Defendants' construction, which required an IP address. Later, at trial, it prevented the jury from reconstructing the term by stopping Defendants' expert, Dr. Dan Wallach, from repeating to the jury that the

• ***Summit 6, LLC v. Samsung***  
1283, 1291 (Fed. Cir. 2015)

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F.3d 1197, 1206–07 (Fed. Cir. 2010)

*Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197 (2010)  
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Proactive Treatment  
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626 F.3d 1197  
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## Opinion

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# **U.S. Patent No. 9,188,408**

## ***Auto-Locking Adjustment Device***



# **“Locking Mechanism” and “Button”**

## **(Common Issues)**

# TWO KEY DISPUTES

Leupold	Nightforce
<b>Locking Mechanism</b> Plain meaning. Needs no construction.  Alternatively: a mechanism for securing a structure in a position	<b>Locking Mechanism</b> a system of parts that includes a linkage, a locking pin, and wedge pin that provide a locking capability
<b>Button</b> Plain meaning. Needs no construction.  Alternatively: a manually depressible actuator	<b>Button</b> a component, <b>separate from the locking mechanism</b> , that is triggered by a user so as to cause an actuator to contract [sic] the linkage of the locking mechanism and move the locking mechanism



# EXEMPLARY EMBODIMENTS DO NOT LIMIT BROADER CLAIM LANGUAGE

- ***InterDigital Cmm'cns v. ITC***, 690 F.3d at 1328 (Fed. Cir. 2012)
- ***Plantronics v. Aliph***, 724 F.3d at 1350 (Fed. Cir. 2013)
- ***Thorner v. Sony***, 669 F.3d at 1367 (Fed. Cir. 2012)

# SEPARATE CLAIM TERMS DO NOT REQUIRE PHYSICALLY SEPARATE STRUCTURES

- ***Rexnord Corp v. Laitram Corp.***, 274 F.3d 1336, 1343-45 (Fed. Cir. 2001)
- ***Applied Med. Res. Corp. v. US Surgical***, 448 F3d at 1333 n.3 (Fed. Cir. 2006)
- ***Oatey v. IPS Corp.*** 514 F.3d at 1277-78 (Fed. Cir. 2008)



# SEPARATE CLAIM TERM PHYSICALLY SEPARATE

- ***Rexnord Corp v. Laitram*** 1343-45 (Fed. Cir. 2001)
- ***Applied Med. Res. Corp*** F3d at 1333 n.3 (Fed. C
- ***Oatey v. IPS Corp.*** 514 (2008)

Rexnord Corp. v. Laitram Corp., 274 F.3d 1336 (2001)  
60 U.S.P.Q.2d 1851

KeyCite Yellow Flag - Negative Treatment  
Distinguished by *Cambridge Science Corp. v. Cox Communications, Inc.*,  
Fed.Cir.(Cal.), June 29, 2015

274 F.3d 1336

United States Court of Appeals,  
Federal Circuit.

REXNORD CORPORATION, Plaintiff-Appellant,

v.

The LAITRAM CORPORATION and  
Intralox, Inc., Defendants-Appellees.

No. 00-1395-

1

Nov. 15, 2001.

## Synopsis

Patentee brought action against alleged infringer relating to patent on device used in bottling and packaging processes. The United States District Court for the Western District of Wisconsin, *Barbara B. Crabb*, Chief Judge, granted summary judgment of noninfringement. Patentee appealed. The Court of Appeals, *Clevenger*, Circuit Judge, held that term "portion" was required to be interpreted broadly to contemplate parts that were either "separate" or "integral."

Reversed and remanded.

West Headnotes (20)

[1] **Patents**  
In general: comparison with patent claims

**Patents**  
Questions of law or fact

A patent infringement analysis is a two-step process in which the court first determines, as a matter of law, the correct claim scope, and then the fact finder compares the properly construed claim to the accused device to determine, as a matter of fact, whether all of the claim limitations are present, either literally or by a substantial equivalent, in the accused device.

[11 Cases that cite this headnote](#)

[2] **Patents**  
Scope, Standard, and Extent of Review  
Because questions regarding construction of patent claims are issues of law, the Court of Appeals reviews them without deference to the district court.

[Cases that cite this headnote](#)

[3] **Patents**  
Language of claims in general  
The Court of Appeals begins its claim construction analysis with the language of the patent claims.

[28 Cases that cite this headnote](#)

[4] **Patents**  
State of the art  
As a general rule, all terms in a patent claim are to be given their plain, ordinary, and accustomed meaning to one of ordinary skill in the relevant art.

[65 Cases that cite this headnote](#)

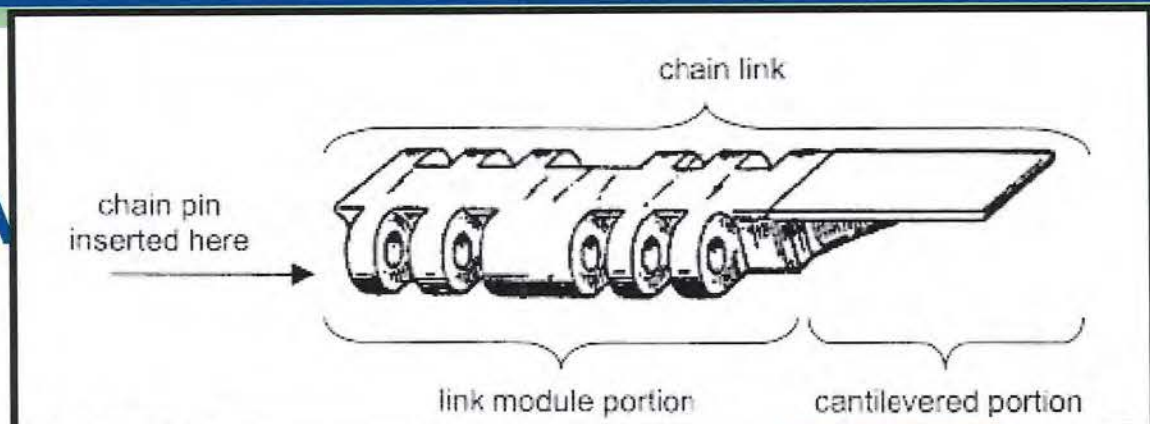
[5] **Patents**  
State of the art  
Unless compelled to do otherwise, a court will give a patent claim term the full range of its ordinary meaning as understood by an artisan of ordinary skill.

[94 Cases that cite this headnote](#)

[6] **Patents**  
Construction of Particular Claims as Affected by Other Claims  
A patent claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent.

[111 Cases that cite this headnote](#)

# SEPARATE CLAIM PHYSICALLY SEPA



- ***Rexnord Corp v. Laitra***  
1343-45 (Fed. Cir. 2001)

- ***Applied Med. Res. Corp***  
F3d at 1333 n.3 (Fed. C

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Nov. 15, 2001.

**Synopsis**  
Patentee brought action against alleged infringer relating to patent on device used in bottling and packaging processes. The United States District Court for the Western District of Wisconsin, [Barbara B. Crabb](#), Chief Judge, granted summary judgment of noninfringement. Patentee appealed. The Court of Appeals, [Clevenger](#), Circuit Judge, held that term "portion" was required to be interpreted broadly to contemplate parts that were either "separate" or "integral."

Reversed and remanded.

West Headnotes (20)

[1] **Patents**  
[In general: comparison with patent claims](#)  
**Patents**  
[Questions of law or fact](#)  
 A patent infringement analysis is a two-step process in which the court first determines, as a matter of law, the correct claim scope, and then the fact finder compares the properly construed claim to the accused device to determine, as a matter of fact, whether all of the claim limitations are present, either literally or by a substantial equivalent, in the accused device.

[Language of claims in general](#)  
 The Court of Appeals begins its claim construction analysis with the language of the patent claims.  
[28 Cases that cite this headnote](#)

[4] **Patents**  
[State of the art](#)  
 As a general rule, all terms in a patent claim are to be given their plain, ordinary, and accustomed meaning to one of ordinary skill in the relevant art.  
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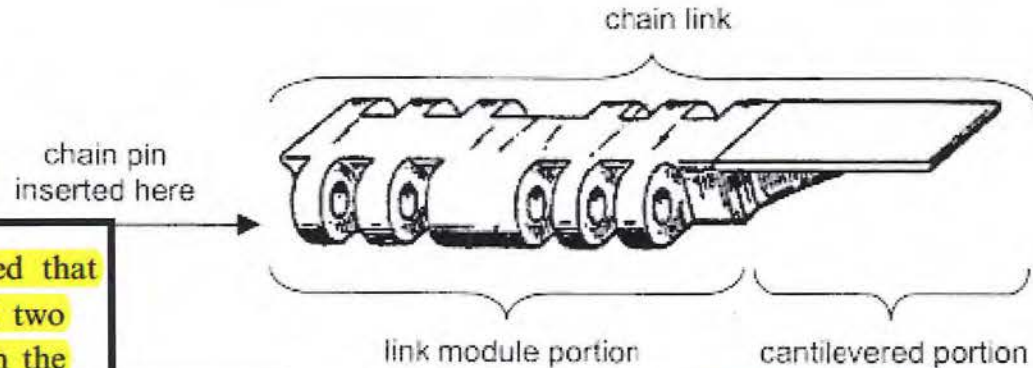
[5] **Patents**  
[State of the art](#)  
 Unless compelled to do otherwise, a court will give a patent claim term the full range of its ordinary meaning as understood by an artisan of ordinary skill.  
[94 Cases that cite this headnote](#)

[6] **Patents**  
[Construction of Particular Claims as Affected by Other Claims](#)  
 A patent claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent.  
[111 Cases that cite this headnote](#)

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# SEPARATE CLAIM PHYSICALLY SEPA



[14] [15] In this case, the district court noted that the plain, ordinary meaning of “portion” included two possible readings—parts that were “separable from the whole” and parts that were “not separated from the whole.” *Rexnord*, slip op. at 24–25. Instead of giving the term the full range of its ordinary meaning (which would encompass both readings), the district court incorrectly concluded that the term was uncertain. *Id.* Upon considering the intrinsic evidence, the district court determined in the first instance that the term should be construed to have the narrower meaning of “separate” parts. In doing so, the district court relied solely on the preferred embodiment in the written description and its drawings (which admittedly reads on the narrower meaning of the key word) and on one passage from the \*1344 prosecution history. Concerning the latter, the district court concluded that the examiner’s objection during prosecution to a particular paragraph structure used in an original claim implied that the examiner viewed the “portions” to be separate pieces. *Rexnord*, slip op. at 36–37. For the reasons explained below, we conclude that the district court erred in its assessment of the written description and of the prosecution history.

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# **“Locking Mechanism”**



# DISPUTE: NF'S ADDED TERMS NOT FOUND IN CLAIM LANGUAGE

Leuopld	Nightforce
<b>Locking Mechanism</b> Plain meaning. Needs no construction.  Alternatively: a mechanism for securing a structure in a position	<b>Locking Mechanism</b> a system of parts that includes a linkage, a locking pin, and wedge pin that provide a locking capability

# SUPPOSED “EXPRESS DEFINITION” IN SPECIFICATION

- Nightforce’s Opening Brief (Dkt. 52 at 26) quoting Col. 7, ll.17-30)
  - Mere discussion of an exemplary preferred embodiment
  - Not limiting features of the invention itself, defined by the broader claims



# SUPPOSED “EXPRESS DEFINITION” IN SPECIFICATION

- Nightforce’s Opening Brief (Dkt. 52 at 26) quoting

In the embodiment illustrated in FIGS. 1, 2, 3, 4, and 5, the assemblage of linkage 170 and locking pin 220 comprise a link that forms part of the locking mechanism. The link of FIGS. 1, 2, 3, 4, and 5 interacts with wedge pin 180 to further form part of the locking mechanism. In other embodiments the locking mechanism includes a link comprising a linkage, such as linkage 170, a locking pin, such as locking pin 220, and a stopping element, such as wedge pin 180. In other embodiments, the locking mechanism includes a link comprising a linkage, such as linkage 170, a locking pin, such as locking pin 220, a stopping element, such as wedge pin 180, and an engagement surface 192. In yet other embodiments, a link may include a linkage and a locking pin that are formed as one item.

exemplary preferred

f the invention itself, defined

by the broader claims

# SUPPOSED “EXPRESS DEFINITION” IN SPECIFICATION

- Nightforce’s Opening Brief (Dkt. 52 at 26) quoting

In the embodiment illustrated in FIGS. 1, 2, 3, 4, and 5, the assemblage of linkage 170 and locking pin 220 comprise a link that forms part of the locking mechanism. The link of FIGS. 1, 2, 3, 4, and 5 interacts with wedge pin 180 to further form part of the locking mechanism. In other embodiments the locking mechanism includes a link comprising a linkage, such as linkage 170, a locking pin, such as locking pin 220, and a stopping element, such as wedge pin 180. In other embodiments, the locking mechanism includes a link comprising a linkage, such as linkage 170, a locking pin, such as locking pin 220, a stopping element, such as wedge pin 180, and an engagement surface 192. In yet other embodiments, a link may include a linkage and a locking pin that are formed as one item.

a locking mechanism carried by the spindle for rotation therewith, the locking mechanism switchable between a locked condition and an unlocked condition; and a button carried by the spindle for rotation therewith and manually depressible transverse to the axis, the button mechanically driving the locking mechanism such that manually depressing the button switches the locking mechanism from the locked condition, wherein the locking mechanism interlocks with the engagement surface and prevents rotation of both the spindle and the button relative to the optical device, to the unlocked condition, wherein both the spindle and the button are rotatable about the axis relative to the optical device and the engagement surface.

by the broader claims



# NO CLEAR DISAVOWAL OF CLAIM SCOPE IN PROSECUTION HISTORY

- Talpe reference:
  - Safety door knob with NO LOCKING MECHANISM at all
  - Knob always rotates freely, only connects to spindle when button pressed

**“Button”**



# TWO KEY DISPUTES

Leupold	Nightforce
<p><b>Button</b></p> <p>Plain meaning. Needs no construction.</p> <p>Alternatively: a manually depressible actuator</p>	<p><b>Button</b></p> <p>a component, <b>separate from the locking mechanism</b>, that is triggered by a user so as to cause an actuator to contract [sic] the linkage of the locking mechanism and move the locking mechanism</p>

# NO REQUIREMENT OF PHYSICALLY SEPARATE BUTTON AND LOCKING MECHANISM

- ***Rexnord Corp v. Laitram Corp.***, 274 F.3d 1336, 1343-45 (Fed. Cir. 2001)
- ***Applied Med. Res. Corp. v. US Surgical***, 448 F3d at 1333 n.3 (Fed. Cir. 2006)
- ***Oatey v. IPS Corp.*** 514 F.3d at 1277-78 (Fed. Cir. 2008)



# NO BASIS TO INCLUDE “ACTUATOR” AND “LINKAGE” IN DEFINING “BUTTON”

- Claim language omits these additional elements
- Improper to limit broader claim term (button) to specific embodiment in specification/figures
  - (E.g., *Thorner*)

# NO BASIS TO INCLUDE “ACTUATOR” AND “LINKAGE” IN DEFINING “BUTTON”

a locking mechanism carried by the spindle for rotation therewith, the locking mechanism switchable between a locked condition and an unlocked condition; and  
a button carried by the spindle for rotation therewith and manually depressible transverse to the axis, the button mechanically driving the locking mechanism such that manually depressing the button switches the locking mechanism from the locked condition, wherein the locking mechanism interlocks with the engagement surface and prevents rotation of both the spindle and the button relative to the optical device, to the unlocked condition, wherein both the spindle and the button are rotatable about the axis relative to the optical device and the engagement surface.



### **CERTIFICATE OF SERVICE**

I hereby certify that I served the foregoing on the following named persons on the date indicated below by

- ☐ mailing with postage prepaid
- ☐ hand delivery
- ☐ facsimile transmission
- ☐ overnight delivery
- ☐ Email
- ☒ notice of electronic filing using the CM/ECF system

to said persons a true copy thereof, contained in a sealed envelope, addressed to said persons at his or her last-known addresses indicated below.

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